Supreme Court, U.S.
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No. _____

# In the Supreme Court of the United States

STUART Y. SILVERSTEIN,
*Petitioner*,

v.

PENGUIN PUTNAM, INC.,
*Respondent*.

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit**

## PETITION FOR WRIT OF CERTIORARI

MARK A. RABINOWITZ
*Counsel of Record*

NEAL, GERBER & EISENBERG LLP
TWO NORTH LASALLE STREET
SUITE 2200
CHICAGO, IL 60602
(312) 269-8000

Becker Gallagher Legal Publishing, Inc. 800.890.5001

## QUESTIONS PRESENTED FOR REVIEW

The Second Circuit's decision in the instant case presents an important question regarding this Court's pronouncement as to the level of original creativity necessary to confer copyright protection upon a compilation under Sections 101, 102 and 103 of the Copyright Act of 1976, 17 U.S.C. §§ 101, 102, 103. This Court has held that "the requisite level of creativity is extremely low" and even a "minimal amount" is sufficient to make the compilation copyrightable.[1] *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345, 348, 111 S. Ct. 1282, 1287, 1289 (1991). This Court further held that a compilation is entitled to copyright protection unless it occupies "a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." 499 U.S. at 359, 111 S. Ct. at 1294. Several Circuits have consistently interpreted and applied this Court's standard.

The Second Circuit considered Penguin's copying of Silverstein's book, *Not Much Fun*, ***verbatim*** by literally cutting the book apart and pasting the pages into its manuscript for its book *Complete Poems*. Silverstein demonstrated that he exercised subjective creative judgment by selecting for inclusion in his work items that are not objectively recognizable, and have never previously been classified, as poems. This uncontroverted evidence, constituting vastly more than a "minimal amount" of

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[1] The most authoritative American dictionary defines "minimal" as "constituting the least possible in size, number or degree; extremely minute." *Webster's Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971 ed.) at 1438.

creativity, alone satisfies the *Feist* test for originality. However, the Second Circuit effectively held that a far greater level of creativity – and one that effectively flouts the *Feist* standard – must be shown in order to qualify for copyright protection. Thus, this Petition presents the question whether the Second Circuit's decision (1) conflicts with the decisions of other United States courts of appeals on the same important matter, namely, the level of original creativity necessary to confer copyright protection upon a compilation under Sections 101, 102 and 103 of the Copyright Act of 1976, 17 U.S.C. §§ 101, 102, 103; and/or (2) apparently and directly conflicts with relevant decisions of this Court. Sup. Ct. R. 10(a), (c).

## PARTIES TO THE PROCEEDING AND RULE 29.6 STATEMENT

Petitioner, Stuart Y. Silverstein is a citizen of the State of California.

Respondent, Penguin Putnam, Inc., now known as Penguin Group (USA) Inc., is a wholly owned subsidiary of its parent corporation, Pearson-Longman, Inc., which is indirectly owned by Pearson plc., a public corporation.

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## PETITION FOR WRIT OF CERTIORARI

Petitioner, Stuart Y. Silverstein, respectfully petitions for a writ of certiorari to review the decision and opinion of the United States Court of Appeals for the Second Circuit entered on May 7, 2004.

## OPINIONS BELOW

The Opinion of the Court of Appeals has been published at *Silverstein v. Penguin Putnam, Inc.*, 368 F.3d 77 (2d Cir. 2004), and is reproduced in Appendix B. The prior Opinion of the United States District Court for the Southern District of New York is reproduced in Appendix C.

## JURISDICTION

The Court of Appeals' decision was entered on May 7, 2004. Silverstein filed a timely petition for rehearing on May 21, 2004. The Court of Appeals denied Silverstein's petition on August 23, 2004. (App. 1a-20a.) This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

## STATUTE INVOLVED

Section 101 of the Copyright Act of 1976, 17 U.S.C. § 101, provides:

> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

Section 102 of the Copyright Act of 1976, 17 U.S.C. § 102, provides:

> (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived,

reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Section 103 of the Copyright Act of 1976, 17 U.S.C. § 103, provides:

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting

material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, subsistence of, any copyright protection in the preexisting material.

## STATEMENT OF THE CASE

### A. Factual Background

While Dorothy Parker collected most of the poems and free verses that she wrote during her career in three books of original poetry and two subsequent compilations, she chose not to collect many other such works. (*Not Much Fun* (Dannay Declaration, Ex. B), at 62-63.) Plaintiff-Petitioner, Stuart Y. Silverstein ("Silverstein") spent over one thousand hours at several libraries around the country searching in numerous periodicals and newspapers from 1915 through 1944 for items that could have been written by Parker. (Silverstein Deposition, at 135-136; Silverstein Interrogatory Answers, at ¶ 1; Originally Published Poems (McCabe Declaration, Ex. 20); Silverstein Declaration, at ¶¶ 3-4.) Silverstein then selected 122 items from a vastly larger pool of items attributed to Parker by making subjective judgments as to whether each item was, in his subjective opinion, written by Parker and, if so, whether it was a poem or verse or not. (Silverstein Deposition, at 42-64, 107-108, 143-145.) Silverstein further determined whether to select free verses to appear in a collection that by its very title was limited to poems. (Silverstein Deposition, at 137-139; Silverstein Interrogatory Answers, at ¶ 1(c); Silverstein Supplemental Interrogatory Answers, at ¶ 1(c).) Silverstein also exercised his subjective creative judgment in the coordination and arrangement of the Parker items by devising standard protocols for titling and editing changes, specifically punctuation, capitalization and indentation and particularly for distinguishing identically-titled poems and verses. (Silverstein

Deposition, at 66-99; Silverstein Interrogatory Answers, at ¶¶ 4(a), 5(a); *Not Much Fun* (Dannay Declaration, Ex. B), at 174.)

Silverstein did not merely locate and arrange items that are objectively recognizable as Parker's poems. Rather, Silverstein determined to be poems and selected for *Not Much Fun* **short passages that he found buried in multi-page book reviews,[2] a chatty personal letter,[3] and even a magazine ad** intended to promote sales of another poet.[4]

In May 1994, during the course of this work, which consumed more than a year, Silverstein met Jane von Mehren, then the executive editor of Viking Penguin (the predecessor entity to Defendant-Respondent, Penguin Putnam, Inc. ("Penguin")). (Silverstein Deposition, at 149-151; Von Mehren Deposition, at 61.) Silverstein told her that he "was doing some research and found some stuff of Dorothy Parker's that apparently had not been published in 70, 80 years." (Silverstein Deposition, at 150.) Von Mehren told Silverstein that she was interested and requested to see some samples and then to see his manuscript. (*Id.* at 150-151.)

In June 1994, Silverstein delivered a manuscript to von Mehren, every page of which carried this notice:

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[2] "Chris-Cross" and "After Dawn" (*Not Much Fun* (Dannay Declaration, Ex. B), at 174, 181; Originally Published Poems (McCabe Declaration, Ex. 20), at 150, 156.)

[3] "Letter to Robert Benchley" (*Not Much Fun* (Dannay Declaration, Ex. B), at 78; Originally Published Poems (McCabe Declaration, Ex. 20), at 60.)

[4] "Letter to Ogden Nash" (*Not Much Fun* (Dannay Declaration, Ex. B), at 180; Originally Published Poems (McCabe Declaration, Ex. 20), at 155.)

"Compilation ©1994 Stuart Y. Silverstein. All rights reserved." (Von Mehren Deposition, at 67-68; Silverstein Manuscript and June 4, 1994 Cover Letter (McCabe Declaration, Ex. 16).) Von Mehren as well as other editors at Penguin understood that Silverstein was asserting a copyright in the compilation of his manuscript. (Von Mehren Deposition, at 68-71; Millman Deposition, at 50-52; Court Deposition, at 33-34.) Penguin's senior editors discussed the manuscript at an editorial meeting and among themselves. (Court Deposition, at 30-35; Millman Deposition, at 38-45; Von Mehren Deposition, at 64-66, 70-71.) Penguin ultimately offered to buy Silverstein's compilation in October 1994 to include in a larger collection of Parker's works. (October 28, 1994 Von Mehren Memo to Peter Lampack (McCabe Declaration, Ex. 17).) Silverstein rejected the Penguin offer. (Von Mehren Deposition, at 60-78; Court Deposition, at 144-145; October 28, 1994 Von Mehren Memo to Peter Lampack (McCabe Declaration, Ex. 17).)

Silverstein ultimately contracted with the Scribner imprint of Simon & Schuster, Inc., which published his book *Not Much Fun: The Lost Poems of Dorothy Parker* ("*NMF*") in July 1996. In 1999, Penguin published *Dorothy Parker: Complete Poems* ("*Complete Poems*"). One discrete 181-page section of *Complete Poems* is titled "Poems Uncollected By Parker," which, with the exception of one item, supplies precisely the same selection of poems and free verses as *NMF*. (*See Complete Poems* (Dannay Declaration, Ex. D); *Not Much Fun* Hardcover Edition (Dannay Declaration, Ex. B); *Not Much Fun* Paperback Edition (Dannay Declaration, Ex. C).) Von Mehren's direct subordinate, Michael Millman, edited *Complete Poems*; von Mehren's direct superior, Penguin Putnam publisher Kathryn Court – the top editor for the Penguin imprint in the United States -- was involved in the decisions to offer to purchase *NMF* and then to approve the

*Complete Poems* project. (Von Mehren Deposition, at 70-73, 77, 89-93.)

It is undisputed that, in preparing *Complete Poems*, either Penguin or its editor, Colleen Breese, bought a hardcover copy of *NMF*, photocopied it (except for one poem), cut apart those photocopies, pasted them onto new sheets of paper and delivered them to Penguin in that form as the "Poems Uncollected By Parker" section of the *Complete Poems* manuscript. Breese further admitted that she submitted the manuscript in that form without changing so much as a single letter in any item and Penguin then published *NMF – verbatim* – as the discrete "Poems Uncollected By Parker" section of *Complete Poems*. (App. 7a; Breese Deposition, at 95-96, 141-143, 156-158, 160, 215, 220-222; Millman Deposition, at 64, 157-159.)

Breese testified that she merely gave "a general look" at the items in the original source and *NMF* in order to determine "[t]hat there were words on the page, it was the format, the title was there. That kind of thing." (Breese Deposition, at 230.) *NMF* neither directly states nor indirectly implies that the poems are identical to the original text. Breese testified that she noticed that Silverstein had created or changed titles for some of the items and even wrote "title?" where those items appeared in her copy of *NMF*. (Breese Deposition, at 196-197, 209; Breese Handwritten Notes on Copy of *Not Much Fun* (McCabe Declaration, Ex. 12) at 174, 181.) Having admittedly explicitly observed that Silverstein had edited *some* parts of the various items from their original forms, Breese could not reasonably have assumed that other parts, *i.e.*, the text, were untouched.

Penguin senior editor Michael Millman testified that Breese submitted to him a manuscript that consisted of "xeroxes of poems that had already been published, [including

the poems and verses published in *NMF*,] which we wanted to go into [*Collected Poems*]." (Millman Deposition, at 233, 237.) With the manuscript, Breese sent a cover letter in which she explicitly described her "cutting and pasting." (August 23, 1998 Breese Letter to Millman (McCabe Declaration, Ex. 7).)

Even though Penguin editors are "instructed to refer potential legal issues that arise in the course of their duties to the company's legal department," Millman, the senior editor of *Complete Poems*, never bothered to consult Penguin's legal department to determine if Penguin's *verbatim* copying of the poems and verses in *NMF* comported with copyright law or company policy. (Millman Deposition, at 17, 89-91, 104-05; Court Deposition, at 178-79.)

Court admitted that she could not recall any other instance during her twenty years of publishing experience in which a publisher photocopied material on which a copyright was explicitly asserted and then republished the material without obtaining permission from the original author. (Court Deposition, at 149-150.) Nor was she aware of another instance in which "Penguin deliberately copied a book in which another publisher/writer asserted a copyright." (*Id.* at 152.) Nor could von Mehren recall having heard of any such conduct in *her* seventeen years' experience in the publishing industry. (Von Mehren Deposition, at 52-54.)

Penguin violated its own policies when it published *NMF verbatim* as a discrete section of *Complete Poems*. (Breese Deposition, at 95-96, 141-143, 156-158, 160, 215, 220-222; Millman Deposition, at 26-32, 63, 157-160; August 23, 1998 Breese to Millman Letter (McCabe Declaration, Ex. 7); Court Deposition, at 23-29, 46-52; *Viking Penguin Authors Guide* (McCabe Declaration, Ex. 10); April 18, 1996 Karen Mayer Letter to All Adult Trade and Mass Market Editors

(McCabe Declaration, Ex. 11).) Penguin did so despite explicitly possessing actual knowledge at the time that Silverstein was asserting compilation copyright protection in *NMF*. (Millman Deposition, at 63-64, 159-161; Von Mehren Deposition, at 68-70; Court Deposition, at 33-34.) Penguin issued seven printings of *Complete Poems* from April 1999 through 2002, at least four of which were released after Silverstein notified Penguin of his claim. (May 17, 2000 Glen Kulik Letter to Phyllis Grann (McCabe Declaration, Ex. 12); Silverstein Declaration, at ¶ 8.)

In the "Note on the Text" found in *Complete Poems*, Penguin falsely asserts that the poems and verses contained in that book are "faithfully reproduced from Dorothy Parker's original collection . . . and [for Poems Uncollected by Parker] from Bookman, Life, McCall's, Nation, New Republic, The New Yorker, New York Herald Tribune, New York World, Saturday Evening Post, Saturday Review, Vanity Fair, Vogue, and Yale Review." (*Complete Poems*, (Dannay Declaration, Ex. D), at xxxix.) Both Breese and Millman admitted that such statement is not now and never was true. (Breese Deposition, at 241-242; Millman Deposition, at 301-304.)

Breese herself questioned whether some of Silverstein's selections actually were poems and whether they should have been selected for *Complete Poems*, but she ultimately decided to defer to Silverstein's creative judgment and, upon that pretext, copied Silverstein's selection. (Breese Handwritten Notes on Copy of *Not Much Fun* (McCabe Declaration, Ex. 12), at 174-182; Breese Deposition, at 196-198.) Penguin also deferred to Silverstein's creative judgment and excluded precisely those items that Silverstein had determined not to select for his compilation, although another scholar previously

had determined several such items to be poems. (Silverstein Deposition, at 45-51; Silverstein Interrogatory Answers, at ¶ 3(a).)

Then, after it flagrantly copied virtually all of Silverstein's book, Penguin took great care to omit from *Complete Poems* any credit or attribution either to Silverstein or his book. Despite all of her professed scholarly work and full citation of all authorities on which she relied in her dissertation, Breese suggested, astonishingly, that Silverstein's name not be mentioned at all in *Complete Poems*: "I don't think we want to direct people to the competition." (August 23, 1998 Colleen Breese Letter to Michael Millman (McCabe Declaration, Ex. 13).) Millman agreed and the book as published fully concealed Penguin's complete reliance on *NMF* for the full text of the "Poems Uncollected By Parker" section of Penguin's book.

**B. The District Court Proceedings**

Silverstein instituted this action by filing a Complaint against Penguin, seeking to redress Penguin's *verbatim* copying and publication of *NMF* as part of *Complete Poems*. In his Amended Complaint, Silverstein asserted claims for copyright infringement, violation of the Lanham Act and immoral trade practices and unfair competition under New York law.

On April 4, 2003, the District Court issued its Opinion and Order which (a) granted Silverstein's summary judgment motion as to liability on all of his claims; (b) denied Penguin's summary judgment motion; (c) stated that Penguin was enjoined from selling or further distributing *Complete Poems*; and (d) scheduled a status conference to consider the specific language of the injunction. (App. 23a-41a.) The District Court held that Silverstein held a valid copyright in *NMF*, finding that his selection, arrangement and coordination of the

material reflected a substantial amount of creativity and judgment that was well beyond the minimum requirement for originality. The District Court also found that (a) Penguin copied *NMF* by photocopying it, cutting-and-pasting the photocopies and republishing them; (b) Penguin's copying infringed Silverstein's copyright; and (c) Penguin's "failure to give any credit or attribution to *Not Much Fun* was deliberate and not inadvertent." The District Court further held that Penguin had (a) violated Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)) by passing off *Complete Poems* as its own work and willfully failing to credit Silverstein; and (b) engaged in immoral trade practices and unfair competition under New York law by failing to designate Silverstein as the source of the work.

On April 14, 2003, Penguin filed its Notice of Appeal challenging the language in the District Court's Opinion and Order that referred to the enjoining of Penguin's sale and further distribution of *Complete Poems*. On June 11, 2003, the District Court entered an Order which permanently enjoined Penguin from publishing, selling or marketing *Complete Poems* and ordered Penguin to recall all unsold copies of *Complete Poems* that already were distributed. (App. 48a-50a.) On that same day, the District Court also issued an Opinion and Order denying Penguin's motion to stay the injunction pending appeal. (App. 42a-47a.) On June 16, 2003, Penguin filed a second Notice of Appeal directed to the Court's June 11, 2003 Order and the two appeals were consolidated. The Second Circuit denied Penguin's motion for stay of the injunction pending appeal on July 21, 2003.

**C. The Court of Appeals' Decision**

The Court of Appeals' decision was entered on May 7, 2004. In its decision, the Court of Appeals considered the creative nature of Silverstein's selection of the items that he

included in *Not Much Fun*. The Court of Appeals stated that "Parker herself created the category of uncollected Parker poems by collecting fewer than all her poems in her lifetime; so that the principle of selection owes nothing to Silverstein." (App. 9a) The Court of Appeals dismissed the evidence that Parker's bibliographer, Calhoun, had classified various items written by Parker as poems or not poems differently than Silverstein had. (App. 9a-12a) The Court of Appeals noted that "Professor Calhoun does not seem to be a party to this scholarly dispute" since "Silverstein has never communicated with Calhoun and has no direct knowledge of what, if anything, he 'concluded.'" (App. 10a) The Court of Appeals further stated that Calhoun and Silverstein may have had alternative rationales for their classifications. (App. 10a-12a)

The Court of Appeals stated that "if the selection process imbues a compilation with the requisite creative spark, the compilation may be protected so long as there are indicia that principles of selection (other than all-inclusiveness) have been employed." (App. 15a) The Court of Appeals then held that Silverstein's selection from a universe of voluminous writings of 122 items that he subjectively determined to be poems written by Dorothy Parker may not qualify for copyright protection as an original compilation because that selection is inherently all-inclusive of the items chosen and therefore not a selection at all. (App. 17a)

The Court of Appeals also held that Silverstein was estopped to claim a copyright on the basis of the 600 punctuation, titling and formatting edits that Silverstein made to standardize the text and titles he created because his book did not contain a notice informing readers that such changes were made. (App. 14a-15a) The Court of Appeals further held that, "[e]ven if Silverstein's creative contribution to the selection of Mrs. Parker's previously uncollected poems is non-trivial, and even if Penguin's appropriation of it was

deliberate, enforcement of his rights by a preliminary or permanent injunction that stops publication of *Complete Poems* is an abuse of discretion." (App. 18a-19a)

The Court of Appeals vacated the District Court's Order entering summary judgment and remanded the action to the District Court for further proceedings to resolve various questions of fact. (App. 19a-20a)

## REASONS FOR GRANTING THE PETITION

This Court should grant Silverstein's Petition for Writ of Certiorari because the Second Circuit in the instant case has entered a decision that (1) conflicts with the decisions of other United States courts of appeals on the same important matter, namely, the level of original creativity necessary to confer copyright protection upon a compilation under Sections 101, 102 and 103 of the Copyright Act of 1976, 17 U.S.C. §§ 101, 102, 103, apparently and directly conflicts with relevant decisions of this Court. SUP. CT. R. 10(a), (c). This Court has held that "the requisite level of creativity is extremely low" and even a "minimal amount" is sufficient to make the compilation copyrightable.[5] *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345, 348, 111 S. Ct. 1282, 1287, 1289 (1991). This Court further held that a compilation is entitled to copyright protection unless it occupies "a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." 499 U.S. at 359, 111 S. Ct. at 1294. Several Circuits have consistently interpreted and applied this Court's

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[5] The most authoritative American dictionary defines "minimal" as "constituting the least possible in size, number or degree; extremely minute." *Webster's Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971 ed.) at 1438.

standard. However, the Second Circuit effectively held that a far greater level of creativity – and one that effectively flouts the *Feist* standard – must be shown in order to qualify for copyright protection.

This Court should note particularly that "minimal," as properly defined and understood, is an oddity which allows more objectively accurate interpretation and application than is allowed by almost any other standard or burden of proof. It is an objectively quantifiable standard; almost all standards and burdens of proof are to greater or lesser extent subjective—and that applies whether the particular standard or burden happens to be "small," or "substantial"; or whether it requires the "preponderance of" or "clear and convincing" evidence; or it triggers yet another search for that elusive "reasonable man"—in fact, with the notable exception of "strict liability," virtually all standards and burdens of proof are ultimately subjective. But "minimal" is *not*: as properly defined and applied, it applies the very specific and quantifiable standard of "any" instances or evidence whatever—that is, one such instance. Here there are *68* instances of original selection alone.

Nor can these 68 instances be characterized as "garden-variety" or "trivial." *Feist*, 499 U.S. at 358-359. Very few compilations are literary in nature; almost are collections of facts: that is, directories, almanacs, and the like. *Feist*, for example, was about a directory. It is clear from the underlying context of that ruling that when Justice O'Connor cautioned about "garden variety" or "trivial" changes, she was thinking about minor and practically unimportant differences in the manner in which the material is presented. Certainly Silverstein would agree that a compilation should not be conferred with copyright protection if the only changes alleged are, for example, to change the headings from boldface to underlined italic on an "Annual

Soybean Production by State" list. But selection is the basic and fundamental underlying element of *any* compilation, and *any* differences in selection—so long as they are not intended solely to distinguish the collection at issue from a previously copyrighted compilation (as properly noted in *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991))—are by their very nature non-trivial.

The Second Circuit acknowledged that Penguin copied Silverstein's book, *NMF*, ***verbatim*** by literally cutting the book apart and pasting the pages into its manuscript for its book *Complete Poems*. (App. 6a-7a) Silverstein demonstrated that in compiling *NMF* he selected 122 items that he subjectively determined to be poems or verses which Dorothy Parker had written, including **short passages that he found buried in multi-page book reviews,[6] a chatty handwritten personal letter,[7] and even a magazine ad.[8]** No one previously recognized these latter items as poems, including Parker's bibliographer, Randall Calhoun. As the District Court correctly recognized, Silverstein made those selections by "relying on his own taste, judgment and informed decision-making." (App. 31a) This uncontroverted evidence, constituting far more than a "minimal amount" of creativity, alone satisfies the *Feist* test for originality.

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[6] "Chris-Cross" and "After Dawn" (*Not Much Fun* (Dannay Declaration, Ex. B), at 174, 181; Originally Published Poems (McCabe Declaration, Ex. 20), at 150, 156.)

[7] "Letter to Robert Benchley" (*Not Much Fun* (Dannay Declaration, Ex. B), at 78; Originally Published Poems (McCabe Declaration, Ex. 20), at 60.)

[8] "Letter to Ogden Nash" ((*Not Much Fun* (Dannay Declaration, Ex. B), at 180; Originally Published Poems (McCabe Declaration, Ex. 20) at 155.)

Silverstein demonstrated at least 68 **documented** instances in which Silverstein and other authorities, including Calhoun, the eminent novelist Somerset Maugham and Penguin's editor, Colleen Breese, disagreed as to whether various items were poems. (Silverstein Deposition, at 43-65, 107-108, 137-139; Silverstein Interrogatory Answers, at ¶¶ 2(a), 2(b), 3(a); Silverstein Supplemental in Interrogatory Answers, at ¶ 1(c); Breese Deposition, at 196-198; Breese Handwritten Notes on Copy of *Not Much Fun* (McCabe Declaration, Ex. 12), at 174-182; Silverstein Manuscript and June 4, 1994 Cover Letter (McCabe Declaration, Ex. 16).) Each of those instances in itself constitutes that "minimal" "creative spark" that is entitled to copyright protection because a selection is original per *Feist* when another person engaging in the same exercise would not necessarily "select the same categories of information." *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 682 (2d Cir. 1998).

Nevertheless, the Second Circuit held that Silverstein's subjective selection may perhaps not be entitled to compilation copyright protection as an original work, despite this Court's holding in *Feist*, 499 U.S. at 345, 348. The Second Circuit's decision relies on an utterly false premise; that is, the issues of whether an item (a) constitutes a poem and (b) was written by Dorothy Parker are objectively determinable – that every scholar would have selected as did Silverstein – despite extensive and explicit evidence to the contrary – that other scholars did *not* select as Silverstein had done. The Second Circuit disregarded Silverstein's exercise of subjective creative judgment by selecting items that are not objectively recognizable, and have never previously been classified, as poems. Silverstein demonstrated conclusively that he did not merely locate and arrange items that are objectively recognizable as Parker's poems.

Indeed, the Second Circuit's decision in this case conflicts with the decisions of several other circuit courts in its interpretation of this Court's holding in *Feist*. The Second Circuit created this split of authority when it applied a new, more stringent, and unsupported standard to determine when copyright protection should be afforded to a compilation. It is of vital importance to the future of copyright law that this Court grant Silverstein's petition for review because the Second Circuit's ruling sanctions egregious copyright infringement and threatens immediate harm to authors of compilations whose original works actually are protected by copyright. It is also important that this Court seize this opportunity to mend this split of authority because it involves a very important issue of copyright law.[9]

### A. The Second Circuit's New Standard for Copyright Protection of Compilations Conflicts with the Decisions of Other Circuits.

The Second Circuit in the instant case departed from the precedent of several other circuit courts when it articulated a standard for measuring whether a compilation is entitled to copyright protection that is different from the other circuits' interpretation of the standard set out by this Court in 1991 in

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[9] The interlocutory nature of the Second Circuit's ruling does not militate against its review by this Court. This Court's resolution of the issue in the Petition will hasten the completion of this litigation and the issue in the Petition is "fundamental to the further conduct of the case." *Land v. Dollar*, 330 U.S. 731, 734, 67 S. Ct. 1009, 1010 n.2 (1947). Additionally, as discussed below, the Second Circuit's decision "is clearly erroneous under [this Court's] precedents" and will produce "immediate consequences," given the Second Circuit's reversal of the District Court's injunction." *Mazurek v. Armstrong*, 520 U.S. 968, 975, 117 S. Ct. 1865, 1868 (1997).

*Feist*. Most circuits have interpreted the *Feist* "minimal degree of creativity" test to mean that a court rarely will hold that a compilation displaying the author's personal subjective selection, coordination or arrangement contains insufficient creativity to render it a protected original work of authorship. These circuits have held that ultimately *Feist* only requires a minute amount of creativity to establish originality warranting copyright protection.

Apparently the Second Circuit did not believe that *Feist* clearly stated that the ultimate inquiry under the originality test is **whether** there was minimal creativity in selection, coordination or arrangement of the material, not the **precise degree** of such creativity or whether that creativity is **pervasive**. Under the Second Circuit's decision, an author's subjective personal selection of items from a greater universe (Silverstein's selection of what he considered to be Dorothy Parker's poetry from a voluminous universe of writings) may not be entitled to compilation copyright protection because that selection is inherently all-inclusive of the items chosen and therefore not a selection at all – in other words, once Silverstein made his original and creative selections, he made no further original and creative selections. (App. 5a, 9a, 15a) The Second Circuit's decision conflicts with the decisions of other circuits because, instead of determining whether a compilation involves an original creative process, it evaluates that creativity only after saddling Silverstein with some additional unarticulated standard or measure.[10]

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[10] The Second Circuit itself tacitly acknowledged that it erred by inappropriately changing the standard for copyright protection despite possessing no authority to do so. In a later decision, the Second Circuit cited its *Silverstein* decision in stating that a protectable compilation merely requires an original selection that displays a "minimal degree of creativity," and that "selection"

In *Feist*, this Court declined to extend copyright protection to the compiler of a white pages telephone directory and provided guidance on how courts should analyze compilations for purposes of copyright protection. Several Circuits interpreted this Court's guidance that a compilation should be afforded protection so long as it was created independently and unless it falls in the "narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." 499 U.S. at 358-359. *See, e.g., Mid America Title Company v. Kirk*, 881 F.2d 417, 420 (7th Cir.1993) (holding that "only a modicum of originality in the selection process") (*citation omitted*); *Alcatel USA, Inc. v. DGI Technologies, Inc.*, 166 F.3d 772, 787 (5th Cir.1999) (holding that the "requisite level of creativity is extremely low" and that some creative spark is sufficient, "no matter how crude, humble or obvious") (*citations and quotations omitted*).

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implies some judgment in choosing facts from a given body of data." *MyWebGrocer v. Hometown Info., Inc.*, 375 F.3d 190, 193 (2nd Cir. 2004). As if in tacit admission that it had articulated an additional and unwarranted element, the court then added that it had recently held in the instant case that "if the selection process **imbues** a compilation with the requisite creative spark, the compilation may be protected so long as there are indicia that principles of selection (other than all-inclusiveness) have been employed." *Id.* (emphasis added). "Imbue" is defined as "to tinge or dye deeply" or to "permeate." *Webster's Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971 ed.) at 1129. The Second Circuit apparently erroneously believes that, even where a "minimal degree of creativity" has been demonstrated, the author must further establish that the selection imbues or permeates the entire work with a "creative spark." This Court's decision in *Feist* imposes no such additional – and onerous – requirement.

The District of Columbia Circuit applied such an interpretation of *Feist*. *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992). The court applied the Feist rules to a video game because it found the audiovisual work to be analogous to the compilation of facts discussed in *Feist*. *Id.* at 245. The court held that this Court's discussion of the creativity standard "left no doubt that the requirement is indeed modest . . . ." *Id.* at 244 (*citations omitted*). The court further noted that *Feist* teaches that the "vast majority of works make the [copyright] grade quite easily" and that the protection threshold should not be ratcheted up "beyond the minimal creative spark required by the Copyright Act and the Constitution." *Id.* at 247 (*citations and quotations omitted*). Applying this standard, the D.C. Circuit held that the video game at issue was entitled to copyright protection. While the game was a fairly simple use of commonplace shapes, the court found that the abstract representation in the game was creative, noting, for example, that the choice of colors and shapes were not an obvious or inevitable choice. *Id.*

The Ninth Circuit also applied this interpretation of *Feist* in a unique case involving a book of alleged revelations from celestial beings. *Urantia Foundation v. Maaherra*, 114 F.3d 955, 959 (9th Cir. 1997). Avoiding the question of who authored the revelations, the court determined the book was a compilation, assuming that the revelations were the equivalent of non-copyrightable facts. Quoting *Feist*, the court held that copyright protection would only be withheld if the book belonged to "that narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 959. The court found that the authors "chose and formulated the specific questions asked . . ." of the celestial beings and held that the selection of the revelations "could not have been so 'mechanical or

routine as to require no creativity whatsoever." *Id.* at 959, *quoting*, *Feist*, 499 U.S. at 362, 111 S. Ct. at 1296.

The Second Circuit's application of its new standard to the facts of this case illustrates its departure from the precedent of the other circuits. The Petitioner in this case, Silverstein, searched through vast and various materials from libraries around the United States and selected what he personally and subjectively considered to be poetry and verses written by Dorothy Parker. (Silverstein Deposition, at 42-64, 107-108, 143-145.) In some instances, he extracted Parker's poetry from short passages that he found buried in multi-page book reviews,[11] a chatty personal letter,[12] and even a magazine ad intended to promote sales of another poet.[13] No one previously recognized these items as poems, not even Parker's bibliographer, Randall Calhoun. And the reverse also occurred: the record indicates conclusively that in several instances Silverstein *refused* to select items explicitly characterized as "poems" by other authorities – not only by Professor Calhoun, but also by the eminent British novelist Somerset Maugham, among others. The record also conclusively indicates that Silverstein refused to select items that Silverstein believed to be wrongly attributed to Mrs. Parker by other sources, although in those instances the

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[11] "Chris-Cross" and "After Dawn" (*Not Much Fun* (Dannay Declaration, Ex. B), at 174, 181; Originally Published Poems (McCabe Declaration, Ex. 20), at 150, 156.)

[12] "Letter to Robert Benchley" (*Not Much Fun* (Dannay Declaration, Ex. B), at 78; Originally Published Poems (McCabe Declaration, Ex. 20), at 60.)

[13] "Letter to Ogden Nash" (*Not Much Fun* (Dannay Declaration, Ex. B), at 180; Originally Published Poems (McCabe Declaration, Ex. 20) at 155.)

opinions both pro and con were utterly subjective due to the lack of any objective evidence whatever for either side. By the standard applied by several other Circuits, this selection process clearly entitles Silverstein's compilation to copyright protection.

Just as the D.C. Circuit found in *Atari* that the choice of colors and shapes in a video game was entitled to protection, that Circuit would also have protected Silverstein's selection of writings to be included in his compilation of poetry. Similarly, just as the Ninth Circuit in *Urantia Foundation* found creativity in the authors' selection of questions to ask celestial beings, that Circuit would have extended protection to Silverstein's creativity in the investigation and selection of where and what writings would reveal more of Parker's poetry.

Conflicting with the decisions of several other circuits, the Second Circuit held in this case that Silverstein's selection from a universe of voluminous writings of 122 items that he subjectively determined to be poems written by Dorothy Parker may not qualify for copyright protection as an original compilation. The uncontroverted evidence that was adduced clearly demonstrated far more than a "minimal amount" of creativity required under the *Feist* test for originality. While the other circuits have interpreted *Feist* to only withhold copyright protection from that narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent, the Second Circuit held that a compilation is subject to some undefined but vastly higher standard. This contradicts the precedent of the other circuits, which have interpreted *Feist* to extend copyright protection to a compilation even if there is only a modicum of originality

in the selection process. The Second Circuit[14] thereby split with several other circuits when it interpreted *Feist* to withhold copyright protection from compilations when the reviewing court somehow determines that it was not created with **enough** creativity. Therefore, the Second Circuit's interpretation undermines the basic function of the originality test. This Court should seize the opportunity to clarify that minimal creativity is the detectable indicator of originality and not a separate element subject to the arbitrary measure of reviewing courts.

### B. The Second Circuit's Ruling Conflicts With This Court's Decision in *Feist*

The Second Circuit's ruling also apparently and directly conflicts with this Court's decision in *Feist*. In that case, this Court held that "the requisite level of creativity is extremely

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[14] Unfortunately, the Eleventh Circuit also appears to have drifted from the *Feist* moorings. *See e.g., Warren Publ'g, Inc. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir. 1997). *See Ethan R. York, Warren Publishing, Inc. v. Microdos Data Corp.: Continuing the Stable Uncertainty of Copyright in Factual Compilations*, 74 Notre Dame L. Rev. 565 (1999). Like the Second Circuit in the instant case, the Eleventh Circuit "focus[ed] attention on semantics of the lower court rather than on the possible copyrightable aspects of Warren's factbook." 74 Notre Dame L. Rev. at 587. "The Act, and Feist interpreting it, even with all the loose ends it left, made clear that originality is the basis of copyright protection and should be the emphasis of examining courts." 74 Notre Dame L. Rev. at 587-588. "Feist clearly calls for a low standard and does not support the heightened standard the Eleventh Circuit applies to such cases." 74 Notre Dame L. Rev. at 589.

low" and even a "minimal amount"[15] is sufficient to make the compilation copyrightable. *Feist Publ'ns*, 499 U.S. at 348, 111 S. Ct. at 1287, 1289. This Court also held that a compilation is entitled to copyright protection unless it occupies "a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." 499 U.S. at 359, 111 S. Ct. at 1294. Despite demonstrating that Silverstein made a subjective personal selection of items from a greater universe (Silverstein's selection of what he considered to be Dorothy Parker's poetry from a universe of a voluminous quantity of uncollected writings), the Second Circuit held that *Not Much Fun* may not be not entitled to compilation copyright protection because that selection may be all inclusive of the items chosen and therefore not a selection at all. (App. 5a, 9a, 15a)

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[15] As discussed in passing on page 12, footnote 5 above, "minimal" is defined in its primary and most commonly-accepted sense in the three most authoritative English-language dictionaries as follows: (1) the *Oxford English Dictionary 2nd Ed.* (Oxford, England: Oxford University Press, 1989) definition: "extremely small; very slight, negligible; constituting a bare minimum, only just adequate"; (2) the *Webster's Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971, at 1438) definition: "constituting the least possible in size, number, or degree : extremely minute"; and (3) the *Random House Unabridged 2nd Ed.* (New York: Random House, 1987, at 1225) definition: "the least possible." In other words, "minimal" defines the least possible amount that is more than absolutely nothing – that is, a single instance – and is *not* a synonym for "small." As "minimal" is the word the *Feist* court carefully selected and imposed, in its precise and commonly-accepted primary meaning it *does* define the *Feist* standard, and its application here requires only the most rudimentary familiarity with the undisputed facts.

Thus, the Second Circuit's ruling apparently and directly conflicts with this Court's holding in *Feist* by requiring that a far greater level of originality must be shown in order to qualify for copyright protection.

### C. If This Court Declines to Review This Case, Immediate Egregious Copyright Infringement May Ensue

The District Court issued an injunction and then refused the Defendant's request for permission to continue selling its copies of Silverstein's protected compilation while it appealed. Under Second Circuit precedent, to overturn the District Court's issuance of the permanent injunction, Penguin was required to demonstrate that the District Court abused its discretion by relying on clearly erroneous findings of fact or an error of law. *Davis v. N.Y.C. Housing Authority*, 278 F.3d 64, 79 (2d Cir. 2002); *U.S. v. International Brotherhood of Teamsters*, 266 F.3d 45, 49 (2d Cir. 2001); *S.C. Johnson & Son, Inc. v. Clorox Co.*, 241 F.3d 232, 237 (2d Cir. 2001). Nevertheless, after improperly holding that the District Court erred in recognizing Silverstein's copyright, the Second Circuit also reversed the District Court's injunction.

The Second Circuit acknowledged that Penguin's editor "photocopied *Not Much Fun*, cut the poems apart with scissors, and pasted them into the Penguin manuscript chronologically." (App. 7a) The Second Circuit further conceded that Silverstein's selection might have been sufficiently creative to confer copyright protection. (App. 5a, 15a, 18a-19a) Nonetheless, the Second Circuit held that, "[e]ven if Silverstein's creative contribution to the selection of Mrs. Parker's previously uncollected poems is non-trivial, and even if Penguin's appropriation of it was deliberate, enforcement of his rights by a preliminary or permanent

injunction that stops publication of *Complete Poems* is an abuse of discretion." (App. 18a-19a)

The District Court's purported erroneous findings of fact or an error of law appeared to be in its clear failure to grasp the essence of Silverstein's subjective creative selection process. The Second Circuit determined that, because the poems in Silverstein's book were unpublished, Parker herself selected them when she decided not to publish them. (App. 17a) The court also held that Silverstein did not give any "notice or warning" of his selection process other than "completeness." (App. 18a) The court then repeated one of the elements of its new standard of copyright protection and stated that "all" is not a selection. *Id.* Without these erroneous findings, the Second Circuit would not have had a basis for finding that the District Court's injunctive relief was an abuse of discretion.

Silverstein clearly is entitled to injunctive relief which protects him from the effect of Penguin's knowing and calculated copyright infringement. 17 U.S.C. § 503(b). Section 503(b) of the Copyright Act gives courts authority to "order the destruction or other reasonable disposition of all copies or phonorecords found to have been made or used in violation of the copyright owner's exclusive rights," and to compel the infringer to cease selling or further distributing infringing material. *National Football League v. Primetime 24 Joint Venture*, No. 98 Civ. 3778, 1999 U.S. Dist. LEXIS 15261, at *12 (S.D.N.Y. Sept. 27, 1999), *aff'd* 211 F.3d 10 (2d Cir. 2000). This statutory provision authorizing the issuance of a permanent injunction supplies conclusive and comprehensive legal authority for the injunction granted by the District Court. *See Sub-Contractors Register, Inc. v. McGovern's Contractors & Builders Manual, Inc.*, 69 F.Supp. 507 (S.D.N.Y. 1946) (destruction of all infringing materials, and the means to produce them, were appropriate

remedies against book publisher who infringed Silverstein's copyright and competed unfairly against him).

The District Court's injunction does not preclude Penguin or anyone else from publishing Parker's "complete" poems or complete works. Rather, the District Court's order only protects Silverstein's unique selection, arrangement and coordination in *NMF* and very limited extensions to that selection. The Second Circuit erroneously found that Silverstein's selection represents the mere collection of items that are objectively identifiable as Parker's uncollected poems and that every other scholar embarking upon that task would make the same selection. However, as Silverstein amply demonstrated and the District Court recognized, Silverstein exercised subjective, creative judgment in selecting the poems and verses he collected in *NMF* and made choices from the universe of possible items that were unique and different from those made by other scholars. Silverstein even included as items several short passages that he discovered in multi-page book reviews, a chatty personal letter, and even a magazine ad.

If permitted to stand, the Second Circuit's holding will jeopardize the validity of every compilation copyright and relegate the aggrieved author to the inadequate remedy of mere damages. The Second Circuit's holding erroneously rewards a pirate who steals a copyrighted compilation, even knowingly and deliberately, by permitting him to continue to sell his misappropriated work with impunity. Such a result constitutes a compulsory license with the author being forced to settle for "future damages as a sort of royalty." *National Football League*, 1999 U.S. Dist. LEXIS 15261, at *12. *Accord Paramount Pictures Corp. v. Carol Publ'g Group*, 11 F. Supp. 2d 329, 338 (S.D.N.Y. 1998).

### D. The Importance of Reviewing the Issue in this Case

As even the Second Circuit recognized, Penguin actually cut the poems right out of Silverstein's book and pasted them into its own. The District Court held Penguin accountable for its wholesale appropriation of Silverstein's original work, but the Second Circuit reversed, applying a new and utterly unsupported and unsupportable standard for copyright protection. The Second Circuit's new standard dramatically weakens the copyright protection available to compilations of poetry and other material, as it invites competing publishers to simply appropriate original selections of poetry and other material by cutting and pasting the author's original work and republishing it with impunity. The Court should mend the split in authority caused by the Second Circuit decision because (1) it should preserve incentives for compiling literary and other materials; (2) it should clarify and reinforce the function of the originality test articulated in *Feist*; and (3) this case and area of law are in a good posture for this Court's review.

#### 1. It is Important to Preserve the Protections and Incentives for Authors like Silverstein to Compile Otherwise Unpublished Works

Section 101 of the Copyright Act of 1976 recognizes that original compilations of preexisting materials or data have a unique value that should be recognized and protected as "an original work of authorship." 17 U.S.C. § 101. A compiler of missing works like Silverstein therefore is very important to our society, as he possesses the creative skill to mine what he believed to be poetry from the previously unpublished miscellaneous materials left behind by a great American poet. Silverstein asks not to be compensated for his labor, but for the benefits of his creative contribution, which is his alone and should be recognized and protected as such. Without

such a protection and incentive, scholars like Silverstein almost certainly will be unwilling to undertake to employ their creative talents to make valuable contributions to society like a compilation of poetry.

### 2. This Case and Area of Law Are Appropriate for This Court's Review

First, the legal issues of this case have been fully aired with the benefit of two published decisions on issues that have been heavily litigated for the past 13 years since *Feist*. Second, further rulings on these issues are not likely to resolve the split of authority, as the new standard applied by the Second Circuit is different in a fundamental way and cannot be reconciled with the precedent of the other circuits. Third, Congress cannot be counted upon to resolve this conflict, as the originality requirement is ultimately rooted in this Court's interpretation of the Copyright Act. Fourth, the central issue to be reviewed is whether the Second Circuit's establishment of a new rule of law was proper, making this case a good vehicle for resolving the conflicting standards.

## E. The Second Circuit Erroneously Required Silverstein to Provide Notice of the Elements of His Copyright to a Pirate of His Work

The Second Circuit further held that, despite the prominent display of his copyright notice on *Not Much Fun*, and his compilation copyright registered at the U.S. Copyright Office, Silverstein was required to provide "notice or warning" that his compilation constituted "a selection by him from some larger body of poems, or a creative designation of a work as poetry that might otherwise be deemed something else." (App. 17a-18a) However, the Copyright Act does not require that a copyright holder describe the decisions he made to prepare his manuscript at the risk of losing his copyright protection. In fact, there no longer is any copyright notice

requirement as a condition to copyright protection. 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.02[C][3] at 7-19, § 7.03 at 7-23 n.1 (1987). The display of a copyright notice without more protects the **selection** and arrangement of a compilation despite any "false impression" the public might get from the absence of further information. NIMMER § 7.12[C][1] at 7-97, § 7.12 at 7-98. Nor, as a matter of standard practice, is such explication even expected, let alone required, either by the publisher or the mass market in a trade publication.

### F. The Second Circuit Erroneously Held That Silverstein is Estopped From Asserting Infringement of His Editing Changes

Silverstein asserted that Penguin also infringed his copyright in *NMF* by copying 600 edits that he made to the text and titles he created for untitled items. (App. 14a) In *Feist*, the Supreme Court held that even a "minimal amount" of creativity confers compilation copyright protection. *Feist*, 499 U.S. at 345, 348. Nevertheless, the Second Circuit held that, "even assuming these changes were protectable, Silverstein is estopped from asserting infringement on this basis" because *NMF* "impl[ied] that the works appear as originally published by Mrs. Parker" and did not explicitly state that such changes to the text had been made. (App. 14a)

The Second Circuit cited *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992), in support of that holding, where the court barred an assertion of originality of certain theories where the author had affirmatively "represented" that they were factual. *Id.* at 1075. However, *Arica* requires representation; nowhere does *NMF* represent or even imply that the poems were reproduced without alteration from the original text – and the Second Circuit supplies no such examples from *NMF* – because none appear there. Nor did

the Second Circuit assert that Silverstein made any "representation" or that Penguin relied upon the purported implication.

Further, an author who displays a copyright notice on his work is not required to notify potential pirates of the precise elements of his copyright claim. NIMMER § 7.02[C][3] at 7-19, § 7.03 at 7-23 n.1, § 7.12[C][1] at 7-97, § 7.12 at 7-98. No publishing industry standard, custom or practice requires, or even expects, an author to include such a "Note." Nor did the Second Circuit cite any such authority. The Second Circuit's holding jeopardizes the validity of the copyrights held by the authors of thousands of compilations – and, given the Opinion's expansive language – all copyrighted works which do not contain an explanatory "Note." This likely will cause calamitous consequences in the media and publishing industries.

## CONCLUSION

For the reasons stated, a writ of certiorari should issue to review the opinion of the Second Circuit.

Respectfully submitted,

MARK A. RABINOWITZ
*Counsel of Record*
NEAL, GERBER & EISENBERG LLP
Two North LaSalle Street
Suite 2200
Chicago, Illinois 60602
(312) 269-8000

*Attorney for Petitioner*

## APPENDIX A

## UNITED STATES COURT OF APPEALS
## FOR THE SECOND CIRCUIT

**Nos. 03-7363(L), 03-7627(CON)**

**[Filed August 23, 2004]**

| | |
|---|---|
| STUART Y. SILVERSTEIN, Plaintiff-Appellee, | ) |
| v. | ) |
| PENGUIN PUTNAM, INC., Defendant-Appellant. | ) |

## PETITION FOR REHEARING

A petition for panel rehearing and a petition for rehearing en banc having been filed herein by the appellee Stuart Y. Silverstein.

Upon consideration by the panel that decided the appeal, it is Ordered that said petition for rehearing is **DENIED**.

It is further noted that the petition for rehearing en banc has been transmitted to the judges for the court in regular active service and to any other judge that heard the appeal and that no such judge has requested that a vote be taken thereon.

For the Court,

Roseann B. MacKechnie, Clerk

By: /s/ _____
Motion Staff Attorney

## APPENDIX B

## UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

**No. 03-7363**

**[Filed May 7, 2004]**

STUART Y. SILVERSTEIN,
Plaintiff-Appellee,

v.

PENGUIN PUTNAM, INC.,
Defendant-Appellant.

## OPINION

Before: WINTER, JACOBS, and STRAUB, Circuit Judges.

Penguin Putnam, Inc. ("Penguin") appeals from an order entered on April 4, 2003 in the United States District Court for the Southern District of New York (Keenan, J.), permanently enjoining Penguin from distributing *Dorothy Parker: Complete Poems*. For the following reasons, we vacate the injunction, reverse the district court's grant of summary judgment against Penguin for copyright infringement, and remand for further proceedings.

RICHARD DANNAY, Cowan, Liebowitz & Latman, New York, NY (Thomas Kjellberg, on the brief), for Appellant.

MARK A. RABINOWITZ, Neal, Gerber & Eisenberg LLP, Chicago, IL (Michael A. Carrillo, on the brief), for Appellee.

DENNIS JACOBS, Circuit Judge:

In 1996, Stuart Y. Silverstein published a book of Dorothy Parker poems that had not been collected in the three volumes of poetry she published in her lifetime, that Silverstein had mined chiefly from old magazines and newspapers. Silverstein claims copyright in the selection and arrangement of those poems. (The owner of Mrs. Parker's copyright is not involved in this litigation.) Penguin Putnam, Inc. ("Penguin") was offered the opportunity to publish Silverstein's volume in 1994, but declined. In 1999, Penguin issued *Dorothy Parker: Complete Poems* ("*Complete Poems*"), which is composed of the three volumes published by Mrs. Parker plus all but one of the uncollected poems in Silverstein's book, which are chronologically arranged at the back.

Silverstein asserts claims against Penguin for copyright infringement, violation of the Lanham Act, immoral trade practices and unfair competition, and for an injunction. After a hearing, the United States District Court for the Southern District of New York (Keenan, J.) granted summary judgment in favor of Silverstein as to copyright, Lanham Act, and immoral trade practices and unfair competition, and it enjoined Penguin from selling or further distributing *Complete Poems*. *See Silverstein v. Penguin Putnam, Inc.*, No. 01 Civ.

309, 2003 U.S. Dist. LEXIS 5487 (S.D.N.Y. Apr. 4, 2003). On March 9, 2004, we vacated the injunction and announced that an opinion would follow.

We conclude that there are material issues of fact as to whether Penguin has taken any creative input by Silverstein that is more than trivial, and we remand for further proceedings. We hold that, in any event, the right asserted by Silverstein is too slight to support an injunction against publication of the Penguin volume: Silverstein holds no copyright in the poems themselves; Penguin has not used Silverstein's arrangement; and the chief principle of Silverstein's selection--that the poems previously had not been collected--reflects an exercise of judgment by Mrs. Parker, not by Silverstein.

Silverstein undertakes to demonstrate a protectible right in the selection by showing that he excluded from his compilation some of the uncollected poems, either because he did not consider them to be "poems" or because he believed they had not been written by Mrs. Parker. There are, however, questions of fact that bear on whether Silverstein is entitled to any protection for his selection of uncollected poems or whether in fact he simply published as many as he could find.

## BACKGROUND

Dorothy Parker, a prolific American poet, short-story writer, screenwriter, and critic, published three volumes of poetry in her lifetime: *Enough Rope* (1926), *Sunset Gun* (1928), and *Death and Taxes* (1931). They have been

continuously in print since 1944 within *The Portable Dorothy Parker*.[1]

Silverstein undertook to compile the poems that Mrs. Parker had omitted from her collections. After more than a year combing back issues of periodicals, including *Vanity Fair*, *The New Yorker*, and *Life*, Silverstein identified 122 uncollected poems. Most are from magazines, some are from newspapers, and two had never been published. He published them in 1996, in a book entitled *Not Much Fun: The Lost Poems of Dorothy Parker* ("*Not Much Fun*").

In 1994, prior to the publication of *Not Much Fun*, Silverstein submitted his manuscript to Penguin for consideration. Each page of the manuscript carried the notation: "Compilation © 1994 Stuart Y. Silverstein. All rights reserved." Penguin offered Silverstein $ 2,000 for the right to publish his compilation as part of a larger volume of Mrs. Parker's work that would include all of her collected and uncollected poems. Silverstein preferred publication in a separate volume.

In 1999, Penguin published *Dorothy Parker: Complete Poems*. This compilation re-published her three existing collections and added at the end a section called "Poems Uncollected by Parker." The end section contained 121 of the 122 poems printed in Silverstein's book,[2] ordered chronologically rather than in Silverstein's more subjective

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[1] Mrs. Parker added one previously uncollected poem to *The Portable Dorothy Parker*: "War Song."

[2] The poem "Day-Dreams," which Silverstein included in *Not Much Fun*, had been collected by Mrs. Parker in *Enough Rope* and was published that way in *Complete Poems*.

arrangement. However, Penguin concedes that the editor who prepared that section photocopied *Not Much Fun*, cut the poems apart with scissors, and pasted them into the Penguin manuscript chronologically. *Complete Poems* does not reference or acknowledge Silverstein or *Not Much Fun*.

Silverstein brought suit in the United States District Court for the Southern District of New York in 2001, alleging that Penguin (i) infringed his copyright under the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*; (ii) engaged in "reverse passing off" in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); and (iii) engaged in immoral trade practices and unfair competition in violation of New York law. Judge Keenan granted Silverstein's motion for summary judgment and permanently enjoined Penguin from further sales or distribution of *Complete Poems*. The court found that *Not Much Fun* was entitled to copyright protection because Silverstein's selection of the poems evinced the level of creativity needed to render it an original work of authorship. He focused on the subjective judgment used by Silverstein in selecting and characterizing the chosen works as poems, "relying on his own taste, judgment, and informed decision-making." *Silverstein*, 2003 U.S. Dist. LEXIS 5487, at *12. The court found that Penguin infringed Silverstein's copyright by copying and pasting his protected selection into *Complete Poems*. *Id.* at *18-*21.

The district court also granted summary judgment for Silverstein on the Lanham Act claim, finding that Penguin's failure to credit Silverstein in *Complete Poems* was a willful false designation. *Id.* at *22-*24. Finally, the court found that Silverstein's state law claims were not preempted by federal copyright law, and it granted summary judgment for him on those claims as well. *Id.* at *25.

The district court denied Penguin's motion for a stay of the injunction pending appeal, finding insufficient likelihood of success on the merits on appeal and no evidence that Penguin would suffer irreparable injury absent a stay. On June 11, 2003, the district court entered a permanent injunction barring Penguin from publishing or selling *Complete Poems*, and requiring a full recall of all existing copies.

This Court heard oral argument in the appeal on January 8, 2004. On March 9, 2004, we vacated the injunction, but warned that vacatur did not signify that judgment would be entered in Penguin's favor, or that Silverstein may not be entitled to recover damages (pursuant to 17 U.S.C. § 504(c)) or costs and attorneys' fees (pursuant to 17 U.S.C. § 505), the amount of which could be affected by Penguin's resumed distribution of *Complete Poems*.

## DISCUSSION

### I

This Court reviews the district court's grant of summary judgment *de novo*. *See Young v. County of Fulton*, 160 F.3d 899, 902 (2d Cir. 1998). In doing so, we are required to view the evidence in the light most favorable to the non-moving party and to draw all reasonable inferences in its favor. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986); *Maguire v. Citicorp Retail Servs., Inc.*, 147 F.3d 232, 235 (2d Cir. 1998). Summary judgment is appropriate only where "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c).

It is well settled that compilations of fact may be copyrightable even though facts themselves are not protected. 17 U.S.C. §§ 102, 103 (2003); *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). Because "the *sine qua non* of copyright is originality," a compilation must possess "at least some minimal degree of creativity" to warrant copyright protection. *Id.* at 346.

Mrs. Parker herself created the category of uncollected Parker poems by collecting fewer than all her poems in her lifetime; so that principle of selection owes nothing to Silverstein. Silverstein claims as his creative contribution the weeding out of works that he did not consider to be poems and of works he believed Mrs. Parker did not write. He undertakes to demonstrate his selectivity by identifying (A) differences in classification between *Not Much Fun* and bibliographies prepared by a Parker biographer; and (B) additions and omissions made to Silverstein's manuscript between the time it was offered to Penguin and the time it was published. Silverstein further claims that his copyediting changes reflect subjective judgment.

**A.**

Silverstein claims that he and Professor Randall Calhoun--a foremost Parker scholar and bibliographer--disagree as to whether certain uncollected Parker works should be considered poems. In particular, Silverstein cites six works that he labeled as poems or verses and included in *Not Much Fun*, but that do not appear on the list of poems published in Calhoun's "bio-bibliography" of Mrs. Parker.[3]

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[3] The six works included in *Not Much Fun* are: "The Passionate Screen Writer to His Love"; "Letter to Robert

Silverstein claims that he classified six items as poems that Calhoun "concluded" were not. However, Professor Calhoun does not seem to be a party to this scholarly dispute. Silverstein has never communicated with Calhoun and has no direct knowledge of what, if anything, he "concluded." Moreover, Calhoun undertakes to list only poems that were published in certain specified periodicals, and he acknowledges that the list may be incomplete even as to those periodicals: "the primary bibliography is as complete as I could make it, given the limitation of time."

As to the six allegedly disputed poems, two of them--"The Passionate Screenwriter to His Love" and "Letter to Robert Benchley"--were, according to Silverstein, never before published; so there is no basis for assuming that Calhoun was aware of them, or that he would have omitted those works if he was.

Little judgment inheres in Silverstein's classification of "Monody" and "Men I'm Not Married To" as (i) poems (ii) written by Mrs. Parker. Both were published as poems, in metered lines and stanzas. "Monody" was signed by Mrs. Parker; "Men I'm Not Married To" was signed by Helen Wells (a near-homophone of "hell on wheels"), a well-known Parker pseudonym. Calhoun's omission of these items does not remotely suggest a scholarly conclusion that they are not poems written by Dorothy Parker.[4]

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Benchley"; "Monody"; "Men I'm Not Married To"; "Chris-Cross"; and "After Dawn."

[4] Calhoun's bibliography also overlooks a number of collected Parker poems that had appeared in the magazines he searched, including "Epitaph"; "Hearthside"; "Pour Prendre Conge"; "The Sea"; and "Autumn Valentine."

"Chris-Cross" and "After Dawn" are verses that were published within book reviews that are listed in the "Book Review" section of Calhoun's bibliography. This classification is not indicative of whether he considered the embedded verses to be "poems." Calhoun did not double-count any items published by Mrs. Parker within his bibliography; each work that he found appeared in one section only. Thus, Calhoun may have pegged "Book Reviews" as the best overall category for these works, whether or not he recognized the embedded verses as poems.

As further evidence of his exercise of judgment and disagreement with Calhoun, Silverstein cites seven works listed as poems in Calhoun's bibliography that Silverstein omitted from *Not Much Fun*. Six of them are classified by Calhoun as one work--"Standardized Song Sheet for Get-Together Meetings"--appearing on a single page in *Life*. The "Song Sheet" is a set of six famous songs to which Mrs. Parker provided alternative words ("Marching Through Georgia"; "A Long, Long Trail"; "Dear Old Pal of Mine"; "Tipperary"; "K-k-k-Katy"; and "Auld Lang Syne"). It is possible that Silverstein omitted the "Song Sheet" because he considered it pastiche or parody rather than Mrs. Parker's own verses. On the other hand, there is a question as to whether Silverstein was aware of the existence of the "Song Sheet" (or of the remaining poem listed by Calhoun) before publication of *Not Much Fun*.

Silverstein has no high regard for the accuracy and reliability of Calhoun's work. He only discovered Calhoun's book "about midway through" his research, and stated that he "used it after I went through and found all the poems myself[;] I went through it to find out if I missed anything." Silverstein culled "two or three items" from Calhoun's book that he had not discovered on his own, all of which had been

published in the *Saturday Evening Post* under one of Mrs. Parker's pseudonyms. He also used the book to locate one uncollected poem called "Balto." But Silverstein seems not to have carefully cross-checked the "Complete Chronology" section of *Not Much Fun* against Calhoun's bibliography. Silverstein lists at the end of his chronology the poems for which he could not find the original publication date; yet Calhoun's bibliography listed original publication dates for at least three of those poems ("The Dramatists"; "Ballade of a Well-Earned Weariness"; and "The False Friends"). Silverstein also omitted from his "Complete Chronology" one previously-collected poem that Calhoun had listed in his bibliography complete with source and publication date ("To a Lady Who Must Write Verse," *The New Yorker*, June 18, 1928).

In short, the inclusion of two (or seven) poems in Calhoun's bibliography does not establish that Silverstein's omission of them reflects a dispute on classification between scholars, or that Silverstein actually knew that the poems he omitted even existed. If Silverstein did not find these poems before submitting the *Not Much Fun* manuscript, there could be no creativity in their exclusion. Morever, even if Silverstein knowingly omitted these poems, a question still remains as to whether that decision (alone or together with others) imbued his selection with sufficient creativity to warrant copyright protection.

**B.**

As further evidence of his creativity in selection, Silverstein points to twenty-five poems in the final manuscript of *Not Much Fun* that were added after his 1994 submission to Penguin. However, there is no evidence as to when Silverstein discovered those twenty-five items, or when (or

why) he decided to exclude (or add) them. For example, there seems to be no evident reason Silverstein would withhold recognition of "Rosemary [1]" as a poem by Mrs. Parker; it is in iambic pentameter, in two stanzas each composed of two rhyming quatrains, and it appeared originally in the *Saturday Evening Post* under Mrs. Parker's Helen Wells pseudonym. Silverstein stated in his deposition that he had not flagged any works written under Mrs. Parker's pseudonyms before he saw them listed in Calhoun's book; it is therefore possible that he found "Rosemary [1]" and other pseudonymous poems after much of his research had been completed.

Most of the twenty-five "initially excluded" poems appear originally to have been published as poetry, in metered lines arranged in rhymed stanzas. It is unexplained why Silverstein would have deliberately excluded them if he had discovered them prior to 1994; and if Silverstein did not find all or most of these twenty-five poems until after he had submitted the manuscript to Penguin, he would be hard pressed to argue that their subsequent inclusion reflects creative judgment. In any event, there are issues of fact as to the timing of Silverstein's discovery of these poems, and whether his decision to ultimately include them in *Not Much Fun* reflects creative judgment.

Silverstein also cites as evidence of creative selection his ultimate exclusion of four works that had initially been included in the manuscript of *Not Much Fun*. In the 1994 manuscript, the table of contents was divided into two categories, poems and verse, and the four works in question were set apart and listed together approximately four lines below the end of the "verse" category. The removal of these works may reflect a creative judgment that the works are not poems. Calhoun's bibliography categorized the works, called "Figures in American Folk Lore," as prose. There are

questions as to whether these items were excluded because Silverstein decided they were prose, or for some other reason; if so, whether their classification as prose entailed creativity; and if so, whether that example of creativity (alone or with others) fuels a spark sufficient to sustain copyright.

## C.

Silverstein claims to have made 600 copy edits, mainly changes in punctuation, capitalization, indentation, and titling, in order to standardize the text. The district court did not conclude that these emendations were entitled to copyright protection, and Silverstein reasserts infringement of these aspects on appeal.

There is a question as to whether copyediting changes of this kind are sufficiently creative to merit copyright protection. *See Matthew Bender & Co. v. West Publishing Co.*, 158 F.3d 674, 681 n.4 (2d Cir. 1998) (noting that corrections to the text, including punctuation or spelling, may be trivial); *Torah Soft Ltd. v. Drosnin*, 136 F. Supp. 2d 276, 287 (S.D.N.Y. 2001) (Scheindlin, J.) (holding that "functional, as opposed to creative, alteration[s]" are not protectible). Moreover, even assuming these changes were protectible, Silverstein is estopped from asserting infringement on this basis. *Not Much Fun* contains no "Note on the Text" or other advice to the reader that changes were made in punctuation, titling, or formatting, let alone what those changes were. The introduction and dust jacket both imply that the works appear as originally published by Mrs. Parker. A reasonable reader would conclude that Silverstein was reproducing Mrs. Parker's own work. Silverstein cannot now claim that Penguin infringed his selection by copying textual alterations of which he gave no notice. *See Arica Inst., Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992) (plaintiff

estopped from arguing that copyrighted work is creative if work represented as completely factual).

**D.**

A compiler of material previously published by others certainly may enjoy a copyright in the selection if "some minimal level" of creativity has been exercised in the selection process. *See Feist*, 499 U.S. at 348, 358-59. And if the selection process imbues a compilation with the requisite creative spark, the compilation may be protected so long as there are indicia that principles of selection (other than all-inclusiveness) have been employed. *See Matthew Bender & Co.*, 158 F.3d at 687 (finding West's decision to include every record of Supreme Court opinions in a database constituted "no 'selection' at all" for copyright purposes). As discussed, material questions of fact exist as to whether Silverstein exercised creativity in selecting the works for his compilation. Those questions must be answered before the creativity, if any, in his selection process can be assessed. We therefore reverse the grant of summary judgment on the copyright claim and remand for further findings, which in turn will determine whether monetary relief is warranted.

**II**

The grant of a permanent injunction is reviewed for abuse of discretion. *S.C. Johnson & Son, Inc. v. Clorox Co.*, 241 F.3d 232, 237 (2d Cir. 2001). The Copyright Act provides that "[a]ny court having jurisdiction of a civil action arising under this title may . . . grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright." 17 U.S.C. § 502(a). The power is equitable in nature. *See New Era Publ'ns Int'l, ApS v. Henry Holt & Co.*, 873 F.2d 576, 584 (2d Cir. 1989);

*Am. Metro Enters., Inc. v. Warner Bros. Records Inc.*, 389 F.2d 903, 904-05 (2d Cir. 1968).

The grant of injunctive relief is an extraordinary remedy. *See Fishman v. Schaffer*, 429 U.S. 1325, 1325-26, 97 S. Ct. 14, 50 L. Ed. 2d 56 (1976); *Rizzo v. Goode*, 423 U.S. 362, 378, 96 S. Ct. 598, 46 L. Ed. 2d 561 (1976); *Hanson Trust PLC v. SCM Corp.*, 774 F.2d 47, 60 (2d Cir. 1985). In the copyright realm, it has been said that an injunction should be granted if denial would amount to a forced license to use the creative work of another. *See, e.g., Nat'l Football League v. Primetime 24 Joint Venture*, No. 98 Civ. 3778, 1999 U.S. Dist. LEXIS 15261, at *12 (S.D.N.Y. Sept. 27, 1999) (where copyright in telecast of football games was infringed by re-transmission of the games, "the failure to issue a final injunction" would "be tantamount to the creation of a compulsory license, future damages then becoming a sort of royalty"); *Paramount Pictures Corp. v. Carol Publ'g Group*, 11 F. Supp. 2d 329, 338 (S.D.N.Y. 1998) (where infringing publication recapitulated the copyrighted fictitious history of "Star Trek," denial of injunction would render the "copyright holder an involuntary licensor of the copyright to any entity that could be relied on to pay damages"). In many instances, injunctive relief may be the best or only way to preserve the exclusivity of a copyright.

But injunctive relief to enforce a copyright is not compelled. *E.g., Dun v. Lumbermen's Credit Ass'n*, 209 U.S. 20, 23-24, 52 L. Ed. 663, 28 S. Ct. 335 (1908) (injunction "unconscionable" where degree of infringement is slight compared to the injury that would result from injunction); *Love v. Kwitny*, 772 F. Supp. 1367, 1375 (S.D.N.Y. 1991) ("When the injurious consequences to [holder's] copyright from continued circulation of [infringing] book are, if anything, 'trifling,' no injunction is warranted."); *Abend v.*

*MCA, Inc.*, 863 F.2d 1465, 1479 (9th Cir. 1988) (awarding monetary rather than injunctive relief, despite copyright infringement, where plaintiff "has not shown irreparable injury which would justify imposing the severe remedy of an injunction on defendants"); *see also Boisson v. Banian Ltd.*, 280 F. Supp. 2d 10 (E.D.N.Y. 2003) (injunction unnecessary to remedy infringement where threat of future infringing activity is low); 4 Nimmer on Copyright § 14.06 ("where great public injury would be worked by an injunction . . . the courts could . . . award damages or a continuing royalty instead of an injunction"). We conclude, for the following reasons, that any protectible interest Silverstein may have would be so slight that it cannot properly be enforced by a preliminary or permanent injunction.

First, an injunction issued to protect any creative spark contributed by Silverstein will impact the value of the copyright in the poems themselves, which subsists in other hands. Second, *Complete Poems* does not appropriate Silverstein's arrangement; the only copyright claimed by Silverstein that Penguin arguably infringed is in the selection. As to that, the chief principle of selection is that the poems collected by Silverstein were *not* collected by Mrs. Parker in her lifetime. The selection was thus made by Mrs. Parker, and it remained for Silverstein only to gather up the poems she selected for exclusion. Third, the gathering itself was work of a kind that copyright does not protect. *See Feist*, 499 U.S. at 347.

Moreover, the principle of selection adopted by Penguin--completeness--owes little or nothing to Silverstein. The assembly of a complete collection may entail judgments as to variants, attributions, juvenilia, etc. But Penguin evidently did nothing other than publish all the poems it could find in print. To the extent Silverstein's compilation was a selection by him

from some larger body of poems, or a creative designation of a work as poetry that might otherwise be deemed something else, Silverstein gave no notice or warning. The only principle of selection he identified was completeness, insofar as his diligent labor could achieve it. But "all" is not a selection. *See Matthew Bender & Co.*, 158 F.3d at 687.

The clear impression conveyed by *Not Much Fun* is that there was no other principle of selection at work. Silverstein included at the end of *Not Much Fun* a bibliography of poems called "The Complete Chronology"; Silverstein describes it as "a chronological list of *all* of Dorothy Parker's poems and verses." In it, Silverstein lists (chiefly by date) all the poems published during Mrs. Parker's lifetime, all the poems published in *Not Much Fun,* and no others.[5] Thus anyone wishing to compile a complete collection of the poems could conclude that Silverstein's selection of "all" was unprotected, or at most that his selection was guided by some criteria that are not indicated.

Penguin may have had more or better information about Silverstein's contribution based on its receipt of the early manuscript and its negotiations with Silverstein; but an injunction should not be employed to bar Penguin from doing what any other publisher assembling a complete works could do. Even if Silverstein's creative contribution to the selection of Mrs. Parker's previously uncollected poems is non-trivial, and even if Penguin's appropriation of it was deliberate, enforcement of his rights by a preliminary or permanent

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[5] The "Complete Chronology" is followed by an anecdote in which Lord Melbourne gloats on the death of a poet, "I am always glad when one of these fellows dies, for then I know I have the whole of him on my shelf." The anecdote explicitly reinforces the idea that Silverstein's principle of selection is completeness.

injunction that stops publication of *Complete Poems* is an abuse of discretion.

## III

In the re-opened proceedings, the district court may make findings and rulings that bear upon the remaining causes of action or that obviate some of the questions presented. We therefore decline to review the grant of summary judgment on the remaining claims except to remand for further proceedings consistent with this opinion. *See Scottish Air Int'l, Inc. v. British Caledonian Group, PLC*, 945 F.2d 53, 55 (2d Cir. 1991).

Although resolution of the copyright issue is not dispositive of the Lanham Act charge, the resolution of open issues of fact (as to the extent of Silverstein's creative input) may bear on the Lanham Act claim.[6] The state law claims for unfair competition and immoral trade practices likewise may turn on the resolution of the outstanding questions of fact. Finally, vacatur of the injunction may well affect the nature and amount (if any) of damages that may be awarded for claims on which Silverstein may prevail.

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[6] Lanham Act claims are "separate and distinct" from those brought under the Copyright Act, *see Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 781 (2d Cir. 1994); but elements of a copyright infringement inquiry may guide the analysis of a Lanham Act claim for "reverse passing off." In determining whether the work at issue originated with the plaintiff (an element of the claim), we have often turned to copyright law: "it is fair to say that it would constitute a false designation of origin to publish without attribution to its author a work that is original enough to deserve copyright protection." *Id.* at 782.

## CONCLUSION

For the foregoing reasons, we hold that Silverstein's rights are limited to his selection or categorization of some works as "poems" that were written by Mrs. Parker. Whether and to what extent he holds such rights depends upon the degree to which his efforts involved the requisite creativity and were, viewing his collection as a whole, more than de minimis. We therefore vacate the permanent injunction, reverse the district court's grant of summary judgment on the copyright claim, and remand for further proceedings.

## APPENDIX C

## UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

**Nos. 03-7363(L), 03-7627(CON)**

**[Filed March 9, 2004]**

| | |
|---|---|
| STUART Y. SILVERSTEIN, Plaintiff-Appellee, | ) |
| v. | ) |
| PENGUIN PUTNAM, INC., Defendant-Appellant. | ) |

Present:

Hon. Ralph K. Winter,
Hon. Dennis Jacobs,
Hon. Chester J. Straub,
*Circuit Judges*,

### ORDER

Upon due consideration, it is ORDERED that the permanent injunction imposed by the United States District Court for the Southern District of New York on June 11, 2003 against Penguin Putnam Inc. is hereby vacated. Vacatur

of the injunction does not signify that judgment will be entered in favor of defendants, or that plaintiff may not recover damages, 17 U.S.C. § 504(c), or costs and attorneys' fees, 17 U.S.C. § 505, the amount of which may be affected by resumed publication. The Court will consider and decide whether questions of fact remain to be tried, and an opinion of this Court will follow.

For the Court,

Roseann B. MacKechnie, Clerk

By: /s/ _____
Lucille Carr

## APPENDIX D

**UNITED STATES DISTRICT COURT**
**SOUTHERN DISTRICT OF NEW YORK**

**No. 01 Civ. 309 (JFK)**

**[Filed April 4, 2003]**

STUART Y. SILVERSTEIN,
Plaintiff,

v.

PENGUIN PUTNAM, INC.,
Defendant.

**JOHN F. KEENAN, United States District Judge**

## OPINION and ORDER

### Background

Involved here are cross-motions for summary judgment in this copyright infringement and Lanham Act case. Both sides agree that summary judgment is appropriate and that there are no material factual issues as to liability which preclude summary judgment. The issue is whether or not defendant's book, *Dorothy Parker: Complete Poems* ("*Complete Poems*") infringes upon plaintiff's work, *"Not Much Fun: The Lost Poems of Dorothy Parker"* (*"Not Much Fun"*).

### Facts

From 1915 to 1944, the prolific American author and early feminist, Dorothy Parker (1893-1967), wrote poetry. Her poems generally appeared in magazines such as "Vanity Fair," "Life," "The Saturday Evening Post," "The New Yorker" and newspapers. The introductions to both *Not Much Fun* and *Complete Poems* reflect that over the years, Ms. Parker collected her earlier poems and published them in book form. The poetry books were *Enough Rope* (1926), *Sunset Gun* (1928) and *Death and Taxes* (1931). In 1936, she published *Not So Deep as a Well* which contained most of the poems published in the earlier three poetry volumes.

Ms. Parker omitted from these books more than one hundred poems and verses that were published earlier in various periodicals. Some 122 uncollected poems and verses were published in book form in 1996 by Scribner in *Not Much Fun* and have a 1996 copyright notice. These works had been compiled by plaintiff Stuart Y. Silverstein ("Silverstein"), beginning in 1994. In addition to the poems, *Not Much Fun*

contains a detailed introduction written by the plaintiff which supplies much biographical data about Dorothy Parker.

The introduction contains excerpts from some of the Parker poems and many anecdotes about her life and relationships with the literary cognoscenti of between the World Wars America, such as Clare Boothe Luce, Robert Benchley and Franklin P. Adams.

Plaintiff submitted a manuscript of his compilation to defendant Penguin Putnam ("Penguin") in 1994 and was offered $2,000 to publish it as part of a larger collection of Dorothy Parker's poems. Silverstein did not accept this offer and the Silverstein compilation was published in *Not Much Fun* in 1996 by Simon and Schuster.

In 1999, defendant published *Complete Poems* which contained 121 of the previously uncollected 122 Parker poems in *Not Much Fun.* No mention of Silverstein or his compilation was made in *Complete Poems* which has a section called "Poems Uncollected by Parker." This section runs from page 211 through page 391. Except for one poem, which is omitted, it is the same collection as in Silverstein's *Not Much Fun.* Dr. Colleen Breese ("Breese"), the editor and author of the introduction to *Complete Poems,* wrote to Michael Millman, the senior editor of *Complete Poems* on August 23, 1998 in referring to Silverstein's work "... I don't think we want to direct people to the competition ..." McCabe Exh. 13. Thus, it is clear that the failure to give any credit or attribution to *Not Much Fun* was deliberate and not inadvertent. Penguin issued five printings of *Complete Poems* from April 1999 through 2002. McCabe Exh. 12.

Although Silverstein's book, *Not Much Fun,* has as the first part of its title the words, "The Lost Poems of Dorothy

Parker," he used his subjective judgment in compiling it by including therein a series of free verses that are not poems. These are called the "Hate Verses." These verses are all included in *Complete Poems* and are in the section of that work classified in the Index at the beginning of the book as "POEMS UNCOLLECTED BY PARKER." Plaintiff asserts that in collecting these free verses in the book of poems, he was exercising creative judgment which is protected by the copyright laws.xz

On the page titled "A Note on the Text" of "Complete Poems," it states

> The poems that appear here are faithfully reproduced from Dorothy Parker's original collections: *Enough Rope* (1926); *Sunset Gun* (1928); *Death and Taxes* (1931); *Death and Taxes and Other Poems* in *Not So Deep as a Well* (1936); *The Portable Dorothy Parker* (1944); and from *Bookman, Life, McCall's, Nation, New Republic, The New Yorker, New York Herald Tribune, New York World, Saturday Evening Post, Saturday Review, Vanity Fair, Vogue, and Yale Review* ....

At their depositions, Dr. Breese, McCabe Exh. 5 at 242, and Michael Millman, McCabe Exh. 6 at 303, acknowledged that they did not agree with the quoted portion of the text. This is obviously because the previously uncollected poems are not "faithfully reproduced from Dorothy Parker's original(s)" as is pointed out immediately above.

There is no question that when Silverstein met Jane von Mehren in May 1994 when she was defendant's executive editor, he was asserting his copyright and that his compilation

had the copyright notice "Compilation 8 1994 Stuart Y. Silverstein. All rights reserved." McCabe Exh. 9 at 68, 69.

Plaintiff now claims that Penguin infringed his work which had previously been presented to defendant. Both parties move for summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure. Silverstein moves for summary judgment on the issue of liability for copyright infringement, and Penguin moves to dismiss the complaint. Silverstein seeks an injunction prohibiting the sale and distribution of *Complete Poems,* an award of damages and other relief including statutory damages for willful copyright infringement and actual damages for Lanham Act violations.

This Court has jurisdiction over this case as it arises under the Copyright Act, 17 U.S.C. § 103, et seq.; the Lanham Act, 15 U.S.C. § 1125, and under the common law of the State of New York pursuant to 28 U.S.C. §§ 1338(a) and (b).

Venue is proper based on defendant's corporate headquarters being based in the Southern District of New York.

For the reasons outlined below, plaintiff's motion is granted, and defendant's motion is denied.

**Discussion**
**Summary Judgment**

A motion for summary judgment may be granted under Rule 56 of the Federal Rules of Civil Procedure if the entire record demonstrates that "there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 250, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). The

moving parties bear the burden of proving that no material facts are in dispute. *Donahue v. Windsor Locks Bd. of Fire Comm'rs,* 834 F.3d 54, 57 (2d Cir. 1987). When viewing the evidence, the Court must "assess the record in the light most favorable to the non-movant and ... draw all reasonable inferences in its favor." *Delaware & Hudson Ry. Co. v. Consol. Rail Corp.,* 902 F.2d 174, 177 (2d Cir. 1990); *McLee v. Chrysler Corp.,* 109 F.3d 130, 134 (2d Cir. 1997). In determining whether a genuine issue of fact has been raised, a court "must resolve all ambiguities and draw all reasonable inferences against the moving party." *Donahue,* 834 F .3d at 57. Courts should "take care not to abort a genuine factual dispute prematurely and thus deprive a litigant of his day in court." *Id.* at 55. Once the movant shows that there are no genuine issues of material fact, the opposing party must produce sufficient evidence to permit a reasonable jury to return a verdict in its favor, identifying "specific facts showing that there is a genuine issue for trial." *Anderson,* 477 U.S. at 248, 256. If the court finds that there are factual disputes regarding material issues, summary judgment is not appropriate. *See id.* at 249; *see also Repp & K & R Music, Inc. v. Webber,* 132 F.3d 882, 890 (2d Cir. 1997) ("Clearly, the duty of a court on a motion for summary judgment is... not to decide factual issues. In this regard, the court's task is issue identification, not issue resolution.").

**Copyright Infringement**

To establish copyright infringement, plaintiff must prove ownership of a valid copyright and copying of the copyrighted works by defendant. *Eckes v. Card Prices Update,* 736 F.2d 859, 861 (2d Cir. 1984).

### 1. Ownership of a Valid Copyright

A copyright registration is *prima facie* evidence of a valid copyright. *See* 17 U.S.C. § 410(c). Once plaintiff offers a certificate of registration, a rebuttable presumption of validity exists and it is defendant's burden to demonstrate why the copyright claim is invalid. *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 763 (2d Cir. 1991). This presumption is rebuttable and the weight to be accorded thereto is within the Court's discretion. *Diamond Direct, LLC, v. Star Diamond Group, Inc.*, 116 F.Supp.2d 525, 527 (S.D.N.Y. 2000).

In 1996, the Copyright Office issued a registration of compilation copyright in Silverstein's name. Registration Certificate No. TX-4-347-579; McCabe Exh. 31. Defendant offers no evidence that the registration is itself invalid. Rather defendant argues that "Silverstein's 'compilation' is not an original work of authorship, and is thus not entitled to copyright protection as a matter of law." Def.'s Mem. Supp. at 4.

### A. Copyright Protection Afforded to Compilations

While facts themselves are not copyrightable, original compilations of facts, preexisting material or data generally are. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co. Inc.*, 499 U.S. 340, 345, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991). The protection afforded a factual compilation is limited. *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir.1991) ("While the copyright in a factual compilation is thin, we do not believe it is anorexic."). Under the Copyright Act of 1976, a compilation is "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such away that the resulting work as a whole constitutes an

original work of authorship." 17 U.S.C. § 101. A copyrightable compilation must demonstrate (1) the collection and assembly of pre-existing material, facts, or data; (2) the selection, coordination, or arrangement of those materials; and (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an 'original' work of authorship. *Feist,* 499 U.S. at 357. The choices made by the compiler must be made independently and entail a minimal degree of creativity. The second requirement is "key" and "instructs courts that, in determining whether a fact-based work is an original work of authorship, they should focus on the *manner* in which collected facts have been selected, coordinated and arranged." *Id.* at 358 (emphasis added).

To be original, "novelty is not required. Originality requires only that the author make the selection or arrangement independently *(i.e.,* without copying that selection or arrangement from another work), and that it display some minimal level of creativity." *Id.* at 358; *Key Publ'ns,* 945 F.2d at 512. The required level of creativity is "extremely low; even a slight amount will suffice." *Feist,* 499 U.S. at 345. Originality does not require that facts be presented in an "innovative or surprising way." *Feist,* 499 U.S. at 362. "While no precise verbal formulation can capture it, there is some irreducible minimum beneath which a work is insufficiently original to find protection." *Diamond Direct,* 116 F.Supp. at 528 (citation omitted).

Silverstein's selection, arrangement and coordination reflect a substantial amount of creativity and judgment meeting the minimum requirement for originality.

**1. Selection of and characterization of materials as poems**

Selection "implies the exercise of judgment." *Key Publ'ns,* 945 F.2d at 512. In determining the level of creativity involved in the selection process, one must consider whether "industry conventions or other external factors so dictate selection that any person composing a compilation of the type at issue would necessarily select the same categories of information." *Matthew Bender & Co., Inc. v. West Publ'g Co.,* 158 F.3d 674, 682 (2d Cir.1998).

Silverstein exercised judgment in deciding which items to include in his work and how to coordinate and characterize them. Silverstein selected 122 items to include in *Not Much Fun* relying on his own taste, judgment and informed decision-making. He did not use objective criteria or a mechanical formulation in choosing the pieces to include. Silverstein spent a great deal of time locating items written by Parker from which he made his selections. He relied on not just items already classified as poems, but also letters, advertisements, and book reviews. Silverstein determined that seven items that Parker's biographer, Professor Randall Calhoun, had concluded were poems or verses were neither and did not include them in *Not Much Fun.* McCabe Exh. 15 at 45-51, 54-55, 107-08; Exh. 19 at ¶ 3(a). Breese admitted that Calhoun was a well-known Parker scholar. McCabe Exh. 5 at 235. Silverstein also concluded that some items were not written by Parker, even though they had been attributed to her by other sources. McCabe Exh. 15 at 57-65; McCabe Exh. 19 at ¶¶2(a), 2(b). These decisions reflect his subjective judgment.

Defendant's witness Dr. Colleen Breese testified in her deposition that there "could be" conflicting definitions of

what a poem is and that answering the question "what is a poem" is a "scholarly subjective answer, an informed answer." McCabe Exh. 5 at 150-152. Breese in fact questioned some of Silverstein's determinations: "Is this even a poem?" (McCabe Exh. 22 at 174-181) and "Same?" *(id.* at 182), and debated whether to include them in *Complete Poems*. *Id.* at 174-181 ("include?").[1] Parker herself had difficulty describing precisely what constituted a poem. McCabe Exh. 24; *The New Yorker,* Jan. 7, 1928 ("There is poetry, and there is not. You can't use the words good or bad about it. You must know for yourself. Poetry is so intensely, so terribly, personal.")

The fact that *Not Much Fun* purports to be all the uncollected poems does not bar it from protection as determining what encompassed "all" required choices and contemplation. It was not simply all the *works* of Ms. Parker regardless of type. It was limited to her poems, specifically the "lost" ones. A "best of" collection would certainly be entitled to protection. However, the law does not require the compiler to make value judgments regarding or prioritize the items he is selecting and arranging; instead the law requires a minimum amount of originality.

Poems are not facts, nor is Silverstein's characterization of an item as a poem a "theory of fact" as defendant urges in its briefs and at oral argument. *See* Def.'s Mera. Supp. at 7. Against the backdrop of the testimony of defendant's own

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[1] Plaintiff summarized the disputes as follows "Calhoun classified six items as poems or verses that Silverstein did not; Silverstein classified seven items as poems or verses that Calhoun did not; Silverstein classified three items as poems or verses that Breese likely would not; Calhoun classified seven items as poems or verses that Breese did not." Pl.'s Mem. in Supp. at 27.

expert and the thoughts expressed by Ms. Parker herself, it would be improvident for the Court to conclude that determining what is poetry is not a subjective process.

**2. Coordination and Arrangement**

The copyright in a factual compilation is "thin" and limited to the particular selection or arrangement. *Feist,* 499 U.S. at 349, 350-51. The choices regarding selection and arrangement, "so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original" that they are protected by the copyright laws. *Id.* at 348. Arrangement here "refers to the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data as such, for example, the alphabetical, chronological, or sequential listings of data." *Key Publ'ns,* 945 F.2d at 513; *see also Lipton v. Nature Co.,* 71 F.3d 464 (2d Cir. 1995) ("any minimal level of creativity is sufficient to render an arrangement protectible") (citations omitted). Silverstein's arrangement was not simply chronological, alphabetical or in some other standard, predictable format. The arrangement of the poems in Penguin's work is "so strikingly similar" to Silverstein's that it "preclude[s] an inference of independent creation." *Lipton,* 71 F.3d at 472.

Defendant devotes a great deal of time to arguing that the time plaintiff spent reviewing materials to find poems to include in his work is not protected. *Feist,* 499 U.S. at 347 ("[t]he distinction ... between creation and discovery: ... one who discovers a fact is not its 'maker' or 'originator.'"); *Arica Inst., Inc. v. Palmer,* 970 F.2d 1067, 1074-75 (2d Cir. 1992). The statute requires that copyrightability not be determined by "the amount of effort the author expends, but rather by the nature of the final result. To grant copyright

protection based merely on the 'sweat of the author's brow' would risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information." *Fin. Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207 (2d Cir. 1986).

However, plaintiff does not seek protection for his research effort but merely provides a description of the time spent as background to the selection process for which he does seek protection. From his extensive research grew a universe of items from which Silverstein could choose works to include in his compilation. Were he seeking protection for only his research efforts his claims would fail, but because Silverstein seeks protection for the selection resulting from that research and the final product reflected in *Not Much Fun*, he is entitled to protection. *See, e.g., CCC Info Servs., Inc. v. Maclean Hunter Mkt. Reports*, 44 F.3d 61 (2d Cir. 1994) (finding that the Red Book valuations represented prediction based on a multitude of data sources, as well as on professional judgment and expertise).

Plaintiff owns the registration for *Not Much Fun*. Plaintiff has a valid copyright in his work based on the principles underlying protection for compilations.

**B. Infringement of Silverstein's Copyright**

To succeed on his motion, plaintiff must not only prove ownership of a valid copyright but also infringement by defendant of the original elements of his work. *Nester's Map & Guide Corp. v. Hagstrom Map Co.*, 796 F.Supp. 729, 733 (E.D.N.Y. 1992) (citations omitted). Copying can be proved by direct evidence or if such evidence is unavailable, copying may be inferred from the defendant's access to the work and alleged substantial similarity of the infringing work to the

copyrighted material. Here copying has been admitted by defendant. Def.'s Mem. Supp. at 3. Dr. Colleen Breese edited *Complete Poems* and is a Parker scholar who wrote her thesis on Parker. Def.'s Mem. Supp. at 2. "Dr. Breese used photocopies of the text of the Poems in *Not Much Fun* as the source text for the "Poems Uncollected by Parker" published in *Complete Poems."* Def. Mem. Supp. at 3. Breese testified that when preparing *Complete Poems* she bought a copy of *Not Much Fun,* photocopied it in its entirety with the exception of one poem,[2] cut and pasted the photocopies and gave them to Penguin to be the "Poems Uncollected By Parker" section of *Complete Poems.* McCabe Exh. 5 at 95-96, 141-43, 156-58, 160, 215, 220-22. She did not edit or alter the original source submitting it to Penguin as part of her works exactly as it was published. McCabe Exh. 5 at 30-31, 106, 150. In a "Note on the Text" to *Complete Poems,* Penguin states that "[t]he poems that appear here are faithfully reproduced from Dorothy Parker's original collections [listing collections]." *Complete Poems* at xxxix.

Whether a compilation has been infringed requires a "somewhat more refined analysis" than that applied to a wholly original work. *Key Publ'ns,* 945 F.2d at 514. Copiers of a compilation must copy "the principles guiding that selection" in order to infringe a copyright. *Id.* at 516; *Nester's,* 796 F.Supp. at 733. "What must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation." *Key Publ'ns,* 945 F.2d at 514 (citing *Kregos v. Associated Press,* 937 F.2d 700, 709 (2d Cir.

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[2] Breese placed the poem "Day-Dreams" with the collected poems section of *Complete Poems.* Silverstein included the same poem in his uncollected poems.

1991)). The elements of Silverstein's work that are subject to copyright protection are (1) the selection of the poems to be included, (2) the arrangement of the poems within his book.

Having established actual copying, plaintiff must show that the "copying amounts to an improper appropriation by demonstrating that substantial similarity to protected material exists between the two works." *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140 (2d Cir. 1992); *Castle Rock Entertm't, Inc. v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 137 (2d Cir. 1998). If the section of uncollected poems in *Complete Poems* is substantially similar to Silverstein's *Not Much Fun* with regard to the selection of poems and their arrangement, a finding of infringement can be supported.

A critical factor in the analysis is not the *amount* of copying but the "principles guiding selection" of a copied compilation. *Nester's*, 796 F.Supp. at 734 (citing *Key Publ'ns*, 945 F.2d at 516); *Eckes*, 736 F.2d 859 (holding that the copying of less than one third of the listings was irrelevant as those copied had been designated "premium" cards therefore the infringing guide copied that portion based upon the same principle of selection). Here the amount is nearly the entire work and since it was copied exactly, the selection and its guiding principles were also copied. Therefore, defendant's actions rise to the level of infringing copying by qualitative and quantitative standards.

The existence of common errors in the two works demonstrates copying. *See Eckes*, 736 F.3d at 863 ("[C]ourts have regarded the existence of common errors in two similar works as the strongest evidence of piracy.") (internal quotation marks omitted); *Lipton*, 71 F.3d at 471-72 (same).

Based on the admitted "cutting and pasting" and duplication of errors from plaintiff's work into defendant's, the Court finds there to be actionable infringement here. Because defendant admitted to copying *Not Much Fun* wholesale with the exception of one poem, the Court finds this behavior to infringe on plaintiff's copyright.

**C. Lanham Act Claims**

Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), forbids the use of false designations of origin and false descriptions or representations in the advertising and sale of goods and services. This Section prohibits the practice known as "reverse passing off", i.e., the selling of another's product as your own. *See Waldman,* 43 F.3d at 780. Silverstein claims that Penguin is responsible for "reverse passing off".

To prevail on a claim for "reverse passing off", a plaintiff must show: (1) that the work at issue originated with plaintiff; (2) the origin of the work was falsely designated by defendant; (3) the false designation of origin was likely to cause consumer confusion; and (4) that plaintiff was harmed by the defendant's false designation of origin. *Lipton,* 71 F.3d at 473. Silverstein's work is original as a compilation based on the choices made as to selection and arrangement. Penguin did not attribute Silverstein at all in *Complete Poems*. Instead, the book credits Penguin and Breese as originators of the book. Penguin's book contains a copyright notice on behalf of the NACCP (to whom Parker bequeathed her poems in her will) and Breese. This failure to attribute Silverstein constitutes false designation. Without this attribution, consumers are likely to believe that Penguin compiled the previously uncollected works and arranged them whereas in fact the section was selected and arranged by Silverstein. Such a belief will result in consumer confusion. These two works

are competitive in the marketplace. Plaintiff will certainly suffer from the misconception that *Complete Poems* is the primary work in this field or only work when that is not the case. Such a belief would direct all consumers to only one work and cause plaintiff harm.

Plaintiff argues that summary judgment on the Lanham Act claim can be awarded solely on the basis of likelihood of confusion. Defendant argues that it cannot be held liable for "reverse passing off" because plaintiff's work does not meet the originality requirement under the copyright law. An analysis of substantial similarity or of the origin of defendant's work is not necessary where, as is the case here, the copying has been admitted. Because Penguin admitted copying, plaintiff prevails on the basis of likelihood of confusion analysis without analysis under the Copyright law. Nonetheless, were the Court to review this claim under Copyright law, the Court has already held that the work is original and protected. Therefore, defendant's arguments based on originality are moot.

The failure to credit Silverstein was willful. Breese indicated that she did not want to credit Silverstein to avoid directing consumers to the "competition." McCabe Exh. 13. Millman agreed to this exclusion of crediting Silverstein. McCabe Exh. 6 at 181-183, 186-87; McCabe Exh. 2. Further, in a "Note on the Text" to *Complete Poems,* Penguin states that "[t]he poems that appear here are faithfully reproduced from Dorothy Parker's original collections [listing collections]." *Complete Poems* at xxxix. This complete lack of credit in print supports plaintiff's claim. Defendant cannot admittedly copy a source *verbatim* without attribution.

The Court grants summary judgment to plaintiff on his claims arising under the Lanham Act.

**D. State law claims for Immoral trade practices and unfair competition**

Defendant moves to dismiss the state law claims of unfair competition and immoral trade practices on the grounds that they are preempted by federal copyright law. Def.'s Mem. in Supp. at 37 ("Because Silverstein seeks redress for the alleged misappropriation (i.e., copying and distribution) of his work, his common law claims are preempted.").

The Copyright Act preempts state law claims that protect "legal or equitable rights that are the equivalent to any of the exclusive rights within the general scope of copyright as specified" in the federal statue. 17 U.S.C. § 301(a). New York uses an "extra element" test to determine whether a claim is preempted. A claim is not preempted if extra element beyond that needed to prove copyright infringement is required to prove the state law claim. *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 131 (2d Cir. 2000), *rev'd on other grounds*, 529 U.S. 205, 120 S.Ct. 1339, 146 L.Ed.2d 182 (2000); *Archie Comic Publ'ns, Inc. v. DeCarlo*, 141 F.Supp.2d 428, 432 (S.D.N.Y. 2001).

Defendant argues that all the elements of plaintiff's unfair competition claim are the same as those of a copyright infringement action. Plaintiff's unfair competition claim is based not only on defendant's copying of plaintiff's work, but also that defendant committed a false designation of origin or confusion as to source. Pl. Mem. in Opp. at 24. Silverstein alleges that consumers will likely be confused as to the true source of the compilation. Claims based on false designation of origin or confusion as to source are not preempted because the claims require a showing of actual confusion, an element not required of a copyright infringement claim. *Samara Bros.*, 165 F.3d at 131-32; *Twentieth Century Fox Film Corp. v.*

*Marvel Enters., Inc.*, 155 F.Supp.2d 1, 25 (S.D.N.Y. 2001), *aff'd*, 277 F.3d 253 (2d Cir. 2002). Plaintiff also argues that its unfair competition claims covering reverse passing off are not preempted because those claims involve the extra element of misrepresentation or deception. Pl. Mem. in Opp. at 24; *Kaplan v. Stock Mkt. Photo Agency, Inc.*, 133 F.Supp.2d 317, 329 (S.D.N.Y. 2001). Based on the required presence of these elements, the Court finds that plaintiff's unfair competition claims are not preempted.

## CONCLUSION

The Court finds that plaintiff holds a valid copyright in *Not Much Fun* which defendant infringed by publishing *Complete Poems* and grants summary judgment to plaintiff on the issue of liability of copyright infringement. Summary judgment is also granted to plaintiff on the Lanham Act and state law claims. Penguin's cross-motion to dismiss the complaint is denied.

Penguin is enjoined from selling or further distributing *Complete Poems*. A status conference is set for April 21, 2003 at 10 a.m. in Courtroom 20C to discuss the specific language of the injunction, the need for a recall of *Complete Poems* from retail outlets, and to set a date for a hearing and the procedures to be employed in fixing copyright infringement damages and damages for the Lanham Act and state law violations. Plaintiff's request for costs and attorney's fees will be addressed at that conference.

**SO ORDERED.**

**Dated: New York, New York**
**April 4, 2003**

/s/ _____
JOHN F. KEENAN
United States District Judge

## APPENDIX E

**UNITED STATES DISTRICT COURT**
**SOUTHERN DISTRICT OF NEW YORK**

**No. 01 Civ. 309 (JFK)**

**[Filed June 11, 2003]**

STUART Y. SILVERSTEIN,
Plaintiff,

v.

PENGUIN PUTNAM, INC.,
Defendant.

**JOHN F. KEENAN, United States District Judge**

**OPINION and ORDER**

This Court issued an Opinion and Order on April 4, 2003, granting summary judgment to plaintiff and issuing an injunction against the sale and production of defendant's book *Dorothy Parker: Complete Poems ("Complete Poems")* and a recall of same finding that it infringed upon plaintiff's work *Not Much Fun: The Lost Poems of Dorothy Parker ("Not Much Fun"). Silverstein v. Penguin Putnam, Inc.*, 2003 WL 1797848 (S.D.N.Y. Apr. 4, 2003). Defendant filed a notice of appeal under 28 U.S.C. § 1292(a)(1). This section grants

the courts of appeals jurisdiction over certain interlocutory orders of the district courts, including those granting injunctions. Defendant has moved to stay the injunction pursuant to Federal Rule of Civil Procedure 62(c) while the case is pending appeal. For the reasons set forth below, defendant's motion is denied.

Under Federal Rule of Civil Procedure 62(c), the Court must apply a four prong test to determine whether a stay is appropriate: (1) whether defendant has made a strong showing that he is likely to succeed on the merits; (2) whether defendant will be irreparably injured absent a stay; (3) whether issuance of the stay will substantially injure plaintiff; and (4) where the public interest lies. *Hilton v. Braunskill*, 481 U.S. 770, 776 (1987). "These standards are well-established and uncontested by the parties." *Sailor v. Scully*, 666 F. Supp. 50, 51 (S.D.N.Y. 1987). Flexibility is essential when considering those factors. *Cayuga Indian Nation of New York v. Pataki*, 188 F. Supp. 2d 223, 251 (N.D.N.Y. 2002) (citing *Morgan Guar. Trust Co. v. Republic of Palau*, 702 F. Supp. 60, 65 (S.D.N.Y. 1988), *vacated on other grounds*, 924 F.2d 1237 (2d Cir. 1991)). Defendant argues that it has met all these factors and the stay should be granted. The Court will review each factor in turn.

(1) *Likelihood of defendant's success on the merits of its appeal*. In its summary judgment motion, defendant argued that plaintiff's compilation was not copyrightable. Plaintiff correctly notes that defendant repeats in this application the arguments made in its summary judgment motion. Those arguments failed previously and defendant has offered no new evidence or authority to show their likely appellate success since the case was briefed and argued. *See Doe v. Lee*, No. 99 Civ. 314, 2001 WL 536730, at *1 (D. Conn. May 18, 2001). The application for a stay is not meant as a tool to reargue the

merits of the underlying case. *See Marshak v. Reed*, 199 F.R.D. 110, 111 (E.D.N.Y. 2001) (denying stay application).

This is not a preliminary injunction, but a permanent injunction entered after cross motions for summary judgment through which the parties had full opportunity to brief the matter and to be heard. The motion was carefully considered by the court. Both sides presented extensive arguments on the motion. They also wrote extensive letters subsequent to my decision issuing the injunction. The decision was not arbitrary nor did the court abuse its discretion in entering the injunction. The Court did not misapprehend the law or the facts; defendant is simply displeased with the result.

On a motion for a stay, "[t]he probability of success that must be demonstrated is inversely proportional to the amount of irreparable injury plaintiff will suffer absent the stay. Simply stated, more of one excuses less of the other." *Mohammed v. Reno*, 309 F.3d 95 (2d Cir. 2002) (quoting *Michigan Coalition of Radioactive Material Users, Inc. v. Griepentrog*, 945 F.2d 150, 153 (6th Cir. 1991)). As discussed *infra*, plaintiff will suffer significant irreparable harm absent a stay. Therefore, defendant must show a strong possibility of success on its appeal. The Court finds that Penguin has not demonstrated a strong likelihood or even substantial possibility of success on appeal based on this Court's discussion and analysis of the claims and arguments in the April 4, 2003 Opinion.

(2) *Defendant will not be irreparably injured absent a stay*. Removing *Complete Poems* from the marketplace and ceasing its sales undeniably causes injury to defendant. However, Defendant is a major book publisher who will not be gravely injured by this order. This factor weighs in favor of denying the motion for a stay.

(3) *Issuance of the stay will substantially injure plaintiff.* If a stay issues, plaintiff will suffer irreparable harm because a competitive infringing work will continue to be in the marketplace taking away from the prominence and profitability of plaintiff's work. There is no precise way to measure plaintiff's loss of sales during this time. Admittedly, the two works have been competing for the past four years. *Not Much Fun* was published in the summer of 1996. Defendant's work, *Complete Poems,* was published on April 1, 1999. Defendant argues that because the issuance of a stay will not upset the status quo of these parties the motion should be granted. Nevertheless, the Court finds that the status quo has been and will continue to be harmful to plaintiff and should cease.

Defendant argues that plaintiff's delay in filing suit should weigh against the issuance of an injunction. *Complete Poems* was published in the spring of 1999; plaintiff filed his original complaint in January 2001. "Normally, when a copyright is infringed, irreparable harm is presumed; this is because the confusion created in the marketplace will damage the copyright holder in incalculable and incurable ways." *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 124 (2d Cir. 1994). This presumption vanishes if the copyright holder *"unreasonably delays* prosecuting his infringement claim." *Id.* (emphasis added). "[D]elay caused by a plaintiff's good faith efforts to investigate an infringement should not rebut the presumption." *Id.* (finding a six month delay in prosecuting a copyright infringement action was reasonable). Plaintiff claims that he did not become aware of the existence of *Complete Poems* until late 1999 and then began researching his potential infringement claim. Plaintiff then through counsel sent cease and desist letters to defendant which were rejected. Based on the investigative and early legal efforts, the Court finds that the delay here does not warrant the denial of

the injunction nor a stay of entry of the injunction pending appeal.

Defendant argues that plaintiff's injury could be redressed through money damages should plaintiff ultimately prevail after appellate review. Defendant claims that such damages are more appropriate here than injunctive relief because only a portion of *Complete Poems* infringes on *Not Much Fun*. Removing defendant's entire work from the marketplace defendant argues goes too far. However, "in a case in which it is shown that, absent an injunction, the infringer will continue to infringe, the failure to issue a final injunction will ordinarily be tantamount to the creation of a compulsory license, future damages then becoming a sort of royalty." *Nat'l Football League v. PrimeTime 2 Joint Venture*, 52 U.S.P.Q.2d 1615, 1619 (S.D.N.Y. 1999); *Paramount Pictures Corp. v. Carol Publ'g Corp.*, 11 F. Supp. 2d 329, 338 (S.D.N.Y. 1998) ("Allowing this argument to prevail would, in effect, make any copyright holder an involuntary licensor of the copyright to any entity that could be relied on to pay damages."). While plaintiff would be compensated monetarily, the payment of damages does not redress the willful infringement conducted by defendant. To allow defendant to continue to profit and benefit from its infringing work would violate the spirit and function of the copyright law.

(4) *The public interest*. The public has an interest in the dissemination of creative works. Allowing the entry of a stay will permit the public access to two literary works for a longer period of time. The public also has an interest in the copyright laws being properly enforced. The Court finds that this factor does not weigh strongly in favor of either party.

## CONCLUSION

Having considered the four factors, on balance, the Court finds that a stay of the injunction pending appeal is not warranted. The motion to stay the injunction pending appellate review is denied.

**SO ORDERED.**

**Dated: New York, New York**
**June 11, 2003**

/s/ _____
JOHN F. KEENAN
United States District Judge

**UNITED STATES DISTRICT COURT**
**SOUTHERN DISTRICT OF NEW YORK**

**No. 01 Civ. 309 (JFK)**

**[Filed June 11, 2003]**

| | |
|---|---|
| STUART Y. SILVERSTEIN, | ) |
| Plaintiff, | ) |
| | ) |
| v. | ) |
| | ) |
| PENGUIN PUTNAM, INC., | ) |
| Defendant. | ) |
| | ) |

**ORDER**

**JOHN F. KEENAN, United States District Judge**

This matter having come before the Court on cross-motions for summary judgment in this copyright infringement and Lanham Act case, and whereby the Court having considered the Motions, and having granted summary judgment to plaintiff on the issue of liability of copyright infringement, on the Lanham Act, and on all state claims, and the Court having denied Defendant's cross-motion to dismiss the complaint, it is hereby:

ORDERED that Defendant is permanently enjoined from further infringement, in any manner, of Plaintiff's copyright in and to his book *Not Much Fun: The Lost Poems of Dorothy Parker,* and it is further

ORDERED that Defendant is permanently enjoined from publishing, selling, marketing or otherwise exploiting any copies of the book *Dorothy Parker: Complete Poems* that contain the 122 poems and verses compiled by plaintiff in *Not Much Fun,* as well as all plates, masters, galleys and other articles by means of which such copies may be reproduced, and it is further

ORDERED that Defendant shall cause all copies of *Complete Poems* in Defendant's possession, custody or control, and all plates, molds, matrices, tapes, film negatives, or other articles by means of which such copies may be reproduced, to be retained by Defendant under secure conditions that will prevent the printing of, or the sale or other distribution of, *Complete Poems;* and it is further

ORDERED that Defendant shall make a full and complete recall of all copies of *Complete Poems* already distributed so that the infringing portion may be removed; and it is further

ORDERED that within twenty (20) days of the date of this Order, Defendant shall (1) notify each customer to which it has sold or distributed *Complete Poems* that *Complete Poems* has been recalled pursuant to the order of this Court, (2) request the customer immediately to cease the sale or distribution of *Complete Poems* and to return to Defendant all copies of *Complete Poems* in the customer's possession, custody or control, and (3) provide the customer with a reimbursement or credit for the reasonable costs incurred in making such return. In addition, Defendant shall publish a notification in the trade publication *Publishers Weekly* so notifying its customers of the foregoing recall and requesting the return of *Complete Poems* for reimbursement or credit. Defendant shall cause all copies of *Complete Poems* returned to Defendant's possession pursuant to this recall order to be

retained in Defendant's warehouse under secure conditions that will prevent either their sale or other distribution. Defendant is to submit to the Court within sixty (60) days of the date of this Order a sworn statement (1) containing a detailed list of the quantity of books in its possession; (2) averring that defendant is storing all books in a secure location and providing the address of that location; and (3) averring that all such books are carefully segregated from any other books that defendant might store in that location.

**SO ORDERED.**

**Dated: New York, New York**
**June 11, 2003**

/s/ _____
JOHN F. KEENAN
United States District Judge